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No. 372

[redacted]

THE UNITED STATES PRINTING AND LITHOGRAPH COMPANY, PETITIONER,

vs.

GEORGE, COOPER AND COMPANY.

[redacted]

[redacted]

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(33,661)

(33,681)

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1928

No. 372

THE UNITED STATES PRINTING AND LITHOGRAPH COMPANY, PETITIONER,

vs.

GRIGGS, COOPER AND COMPANY

ON WRIT OF CERTIORARI TO THE SUPREME COURT OF THE STATE OF OHIO

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JUDD & DETWEILER (INC.), PRINTERS, WASHINGTON, D. C., NOVEMBER 9, 1928

Supreme Court of Ohio

No. 20435.

THE UNITED STATES PRINTING AND LITHOGRAPH COMPANY,

Plaintiff in Error,

vs.

GRIGGS-COOPER AND COMPANY,

Defendant in Error.

PETITION IN ERROR.

[Filed April 6, 1927.]

Plaintiff in error says that defendant in error, by consideration of the Court of Appeals of the first appellate district, Cincinnati, Ohio, on the twenty-eighth day of February, 1927, at the January Term of said court, obtained judgment and final order against the plaintiff in error in a certain proceeding numbered 2913, pending therein, wherein said plaintiff in error herein was defendant, and said defendant in error herein was plaintiff, by which said judgment and final order said Court of Appeals affirmed a certain judgment and final order of the Court of Common Pleas of Hamilton county, Ohio,

theretofore rendered against the plaintiff in error, and granted an injunction against the plaintiff in error. A transcript of the docket and journal entries thereof in full in said court, together with all of the original papers and printings therein, including a bill of exceptions, are hereto attached and filed herewith.

Plaintiff in error says that there is error in said judgment, final order, records and proceedings in this, to wit:

1.

In failing to reverse the judgment and final order of the Court of Common Pleas for Hamilton county, Ohio, and in refusing to dissolve the injunction granted by said Court of Common Pleas.

2.

In holding "that Section 16 of the trademark act of 1905 does project and protect the trademark rights of the owner into all of the states even in advance of trade."

3.

In construing the trademark act of 1905 contrary to the interpretations placed thereon by the United States district and appellate courts.

4.

In placing a construction upon the trademark act of 1905 that is repugnant to the United States Constitution whereby to render said trademark act unconstitutional, providing said construction of said act by said Court of Appeals, be correct.

5.

In holding that defendant in error is entitled to a monopoly in the use of the word "Home," as applied to various food products, in markets not reached by the defendant in error.

6.

In construing Section 16 of the trademark act of 1905 as giving "protection to the owner in interstate commerce throughout the states, regardless of the extension of trade."

7.

In holding that Article 1, Section 8, Subdivision 3, of the United States Constitution gives Congress the right to regulate commerce among the several states to the extent of creating trademark rights and of projecting and protecting such trademark rights into all of the states in advance of trade under such marks.

8.

In construing the trademark act of 1905 so as to deny and deprive the citizens of the state of Ohio of their rights to and in property as guaranteed to them by the United States Constitution, Article X, and the Ohio Constitution, Article 1, Sections 1, 19 and 20.

9.

In giving judgment for the defendant in error when it should have been given for the plaintiff in error.

Wherefore plaintiff in error prays that the finding, judgment and orders of the appellate court be reversed,

that the injunction be dissolved, and that it be restored to all things it has lost by reason thereof.

WALTER F. MURRAY,
FRANK L. ZUGELTER,
Attorneys for Plaintiff in Error.

WAIVER OF SUMMONS.

Cincinnati, Ohio, April 5, 1927.

The issuance and service of summons in error herein is waived and the appearance of the defendant in error is hereby entered.

COBB, HOWARD & BAILEY,
Attorneys for Defendant in Error.

Transcript of Docket and Journal Entries.

1927, April 6. Petition in error, as of right, and waiver of summons and entry of appearance filed.

1927, April 6. Court of Appeals transcript of docket and journal entries, original papers, bill of exceptions and exhibits filed.

1927, April 6. Motion for an order to certify the record, plaintiff's printed briefs on motion, notice and proof of service filed.

1927, April 18. Printed brief of defendant on motion filed, 4/22/27. Proof of service filed.

1927, April 25. Printed "Decisions of Common Pleas Court and Court of Appeals submitted as addenda to brief of defendant," filed, 4/29/27. Proof of service filed.

1927, April 29. Plaintiff's printed reply, briefs on motion and proof of service filed.

1927, April 29. Original papers taken by Toothaker & Rodenfels, 5/12/27, returned.

1927, May 4. Transcript of docket and journal entries of Court of Appeals filed, and taken by Toothaker & Rodenfels.

1927, May 4. Time for filing printed record extended until May 12, 1927. C. T. Marshall, chief justice.

1927, May 11. Motion for an order directing the Court of Appeals of Hamilton county to certify its record.

1927, May 11. Order No. 958 to clerk of courts to certify record.

1927, May 12. Printed record and affidavits filed.

1927, May 14. Court of Appeals certificate filed.

1927, May 16. Plaintiff's printed briefs re-filed on merits (10 copies) May 18, 1927 — Proof of service filed.

1927, May 16. Plaintiff's printed reply briefs (7) filed.

1927, May 16. Cause stands for hearing on original petition in error filed.

1927, May 20. Plaintiff's printed reply briefs (5) re-filed on merits.

1927, May 20. Plaintiff's printed reply briefs (2) re-filed on merits.

1927, May 21. Printer's receipted bills filed.

1927, June 3. Printed brief of plaintiff and proof of service filed.

1927, July 16. Defendant's printed briefs filed 7/19/27. Proof of service filed.

1927, December 29. Additional authorities of defendant in error and proof of service filed.

1928, January 28. Printed reply brief of plaintiff in error.

1928, June 20. Judgment affirmed.

1928, June 27. Mandate issued.

1928, June 27. Original papers and bill of exceptions sent to clerk.

Journal Entries.

May 4, 1927. Upon application of Toothaker & Rodenfels and for good cause shown, it is ordered that the time for filing printed record herein be, and the same hereby is, extended until May 12, 1927. Enter: C. T. Marshall, C. J.

May 11, 1927. Motion for an order directing the Court of Appeals of Hamilton county to certify its record.

It is ordered by the court that this motion be and the same is hereby allowed.

June 20, 1928. This cause came on to be heard upon the transcript of the record of the Court of Appeals of Hamilton county, and was argued by counsel. On consideration whereof, it is ordered and adjudged by this court, that the judgment of the said Court of Appeals be, and the same is hereby affirmed; and it appearing to the court that there was reasonable grounds for this proceeding in error, it is ordered that no penalty be assessed herein. It is further ordered that the defendant in error recover from the plaintiffs in error its costs herein expended, taxed at $..... Ordered, that a special mandate be sent to the Court of Appeals of Hamilton county, to carry this judgment into execution.

[Duly certified.]

OPINION.

1. By virtue of the provisions of Section 16 of the Trademark Act of 1905 (U. S. Comp. St., 9501) the rights of the registrant of a trademark thereunder are not limited to the territory where his trade in the commodity covered by the trademark is established but extend throughout the states regardless of the actual extension of trade.

2. The provisions of Section 16 of that act, (U. S. Comp. St. 9501) are not violative of the Federal Constitution, but authorized by Section 8 of Article 1 thereof.

(No. 20435 — Decided June 20, 1928.)

Error to the Court of Appeals of Hamilton county.

This action was instituted in the Court of Common Pleas of Hamilton county by the Griggs-Cooper Company against the United States Printing and Lithograph Company. The parties will be referred to as they there appeared.

The plaintiff is a corporation with its principal place of business in St. Paul, Minnesota, its business being that of manufacturing groceries wholesale, and selling groceries and other like goods, wares and merchandise wholesale in Minnesota, Wisconsin, Iowa, North Dakota, South Dakota, Montana and Washington. In the transaction of its business prior to 1901 as a partnership, and since that date as a corporation, plaintiff adopted and used a trademark, "Home Brand," for various and sundry descriptions of goods, wares and merchandise sold by it, and caused said trademark from time to time to be fixed and applied to various kinds of goods, wares and

merchandise, and to be duly registered in the United States Patent Office. The plaintiff has sold in the market in the various states named said goods, wares and merchandise under the designated name and trademark, the dates of the several registrations for the various and divers articles of goods, wares and merchandise beginning with 1905 and ending with 1920. The essential feature of said trademark at all times was the word "Home," and said goods, wares and merchandise were extensively advertised.

For many years the defendant, the United States Printing and Lithograph Company, had printed, published and sold to its customers in the states of Kansas, Illinois, Indiana, Pennsylvania, Missouri, Ohio, Michigan, Virginia, Maryland and Louisiana certain labels upon which the word "Home" appeared in combination with some other word such as "Harvest Home," "Homestead," "Home Wood," "Home Comfort," "Home Town," "Home Club," "Home Run," and others, for all kinds of commodities usually sold by manufacturing grocers and wholesale grocers, including such goods, wares and merchandise as sold by the plaintiff under its registered trademark "Home Brand," and the labels used in relation thereto; and said labels so printed, published and sold by the defendant are used by those who purchase the same from the defendant as a trademark or mark in the sale of such similar articles of merchandise.

After demanding that defendant cease to print, publish and sell labels which were the same or similar to the plaintiff's said labels, or containing the said trademark

"Home Brand" or the distinguishing feature "Home" or any imitation or simulation thereof, for use in the sale of similar products, with which demand defendant refused to comply, plaintiff brought this suit seeking to enjoin the defendant from printing, publishing or selling labels for any kind of grocery commodities as are being sold by the plaintiff in the label of which the word "Home" appears. An injunction was granted by the Court of Common Pleas as prayed, and upon hearing on appeal the Court of Appeals entered a similar order. The latter court, in addition to the facts previously stated, found that plaintiff and its customers advertised extensively said groceries, goods, wares and merchandise under and by means of its said trademark in the states to which its trade had been extended as above set forth, and that plaintiff was the owner of said trademark "Home Brand" and each of said registrations thereof; that the essential feature of said trademark is and was at all times the word "Home," that the plaintiff was at the time of its petition entitled to the exclusive use of said trademarks and each of them on the goods of the several descriptions set forth, and that the registrations under the trademark act of 1905 extended the rights of the plaintiff in the trademark to cover commerce among the states other than the several states where the trade of plaintiff had been established. The court found that the labels printed and published and sold by the defendant constitute wrongful infringement of plaintiff's right to said trademarks, and based its order of injunction upon said finding.

Upon motion the record was ordered certified to this court.

Mr. Walter F. Murray and Mr. Frank L. Zugelter, for plaintiff in error.

Messrs. Cobb, Howard & Bailey and Messrs. Morphy, Bradford, Cummins, Cummins & Lipschultz, for defendant in error.

Matthias, J.:

The outstanding question presented by the conceded facts is whether by the trademark act of 1905 the plaintiff by the various registrations under its trademark is protected throughout the United States, or, as it has been well stated, whether the effect of that act is to project the right of protection in advance of the actual extension and establishment of trade in said commodities by the plaintiff. In the event the question just stated be answered in the affirmative, then we have the further questions whether the act of 1905, particularly Section 16 (Title 15, Section 96, U. S. Code, Section 9051 U. S. Comp. Stats.) is unconstitutional, and whether the printing and furnishing of such labels to be used in the manner stated make the defendant an infringer against whom a suit in injunction may be maintained.

Upon the lesser proposition, that the labels printed by the defendant, although the whole of the trademark of plaintiff is not used therein, constitute an infringement, many authorities may be cited. The general rule is that the use of the key word in the trademark, being the distinctive word therein, though in company with other words, constitutes an infringement if applied to articles

or commodities of a similar character. We shall cite only a few of the cases directly in point.

In the case of Saxlehner v. Eisner & Mendelson Co., 179 U. S., 19, the Supreme Court lays down the rule upon this subject as follows: "It is not necessary to constitute an infringement that every word of a trademark should be appropriated. It is sufficient that enough be taken to deceive the public in the purchase of a protected article." This rule is applied where, as here, the label in question is attached to the vendible article of merchandise similar in character to that covered by the trademark registration. To the same effect is the case of President Suspender Co. v. MacWilliam, 233 Fed., 433.

In the case of Griggs, Cooper & Co. v. Erie Preserving Co., 131 Fed., 359, the court held, "the words 'Home Comfort' are an infringement of complainant's trademark 'Home Brand' used on canned goods, the word 'Home' being the essential feature of it."

In the case of Griggs, Cooper & Co. v. Federal Coffee Mills Co., 46 App. Cases, D. of C., 317, the court applied the rule above stated, and held that "the words 'Home Pride,' as applied to coffee and teas, are so similar to 'Home' and 'Home Brand,' registered as trademarks and applied to the same goods, as to be likely to cause confusion in trade, and are therefore not registerable as a trademark over an opposition by the registrant of the other marks." The conclusion of the court was based upon its finding that the word "Home" is the distinctive mark of the title lawfully registered by Griggs-Cooper & Co.

In the consideration of the question presented, whether the plaintiff's registration of its trade-mark and the rights secured to it thereby serve to protect it in territory in advance of the actual extension and establishment of its trade there, the construction and application of the trademark act of 1905, particularly Section 16, is required. No case has been cited construing or applying this section, and we have found no precedent to assist in the consideration and determination therof. As heretofore stated it is conceded that the plaintiff's business in the commodities bearing the trademark in question is thus far limited to the states in the northwest which have been enumerated, and that the labels, the printing and use of which is here challenged, were for the use of business concerns located in other states. However, it is not disclosed whether the commodities of the business concerns to whom the defendant furnishes said labels, and the plaintiff's goods, bearing its label, are sold in the same market. It has been urged by counsel for the defendant that by the decision of the Supreme Court of the United States in Hanover Star Milling Co. v. Metcalf, 240 U. S., 403, and United Drug Co. v. Theodore Rectanus Co., 248 U. S., 90, the principle has been established that "the adoption of a trademark does not, at least in the absence of some valid legislation enacted for the purpose, project the right of protection in advance of the extension of the trade, or operate as a claim of territorial rights over areas into which it thereafter may be deemed advisable to extend the trade." The above statement is quoted from the opinion in the

Rectanus case, supra. It is followed by the further statement, "and the expression, sometimes met with, that a trade-mark right is not limited in its enjoyment by terirtorial bounds, is true only in the sense that wherever the trade goes, attended by the use of the mark, the right of the trader to be protected against the sale by others of their wares in the place of his wares will be sustained."

It is conceded by counsel for the defendant that the court in the case just referred to did not have before it a situation involving the registration of a trade-mark under the act of 1905. It is only claimed that the court there indicated that when a case that does directly involve the question as to whether the registration of a trademark under the act of 1905 projects the common law right in the trademark beyond the territory in which its trade is actually established the court will decide the question in the negative.

Although the opinion in the Hanover case, supra, is informing and instructive, it is not at all decisive of our question, for in the situation there presented none of the parties had registered a trademark under any act of Congress or under the law of any state. The decision therefore turned upon common law principles of general application. Two cases were decided together. One involved questions growing out of a common law trademark, abandonment, nonuser and estoppel, while the other was a case of unfair competition by reason of imitation or simulation.

It is quite obvious that the act of 1905 had no appli-

cation in either of these cases and did not enter into their consideration. Our question, therefore, is whether Section 16 of the trade-mark act of 1905 (Title 15, Section 96, U. S. Code, Section 9501, U. S. Comp. Stats.) has the effect of projecting the right of protection in advance of the establishment of trade, and whether it is valid. Is it "the valid legislation enacted for that purpose" referred to in the Rectanus case? This Section 16 provides as follows:

> "The registration of a trade mark under the provisions of this subdivision of this chapter shall be prima facie evidence of ownership. Any person who shall, without the consent of the owner thereof, reproduce, counterfeit, copy, or colorably imitate any such trade-mark and affix the same to merchandise of substantially the same descriptive properties as those set forth in the registration, or to labels • • • intended to be used upon or in connection with the sale of merchandise of substantially the same descriptive properties as those set forth in such registration, and shall use, or shall have used, such reproduction, counterfeit, copy, or colorable imitation in commerce among the several states, or with a foreign nation, or with the Indian tribes, shall be liable to an action for damages therefor at the suit of the owner thereof."

This Section 16 was an amendment of Section 7 of the act of 1881, (21 Stats. at L., 503), the material change therein being the insertion of the words, "commerce among the several states," whereas the act previously provided only protection "in foreign commerce or commerce with Indian tribes." If this change does not have the effect of enlarging and extending the rights under a trademark, and provide greater protection than

was theretofore afforded under the common law, no purpose would have been served by the change. This language surely indicates a clear purpose to protect the registrant of a trade-mark further than the state or states wherein his business in the commodities covered by the trademark is actually established. Before the amendment, such limited protection was afforded under the uniform decisions of our courts even where there had been no regulation under the act of Congress. There was of course good reason for not extending the right beyond the zone of established business where there was no registration under the act of Congress, and in the absence of a statute specifically affording that protection, as suggested in the Rectanus case. But does not this statute provide such additional protection as was there suggested might be done? If this statute does not afford such additional protection to the registrant of a trademark the effect of the statute remains exactly the same as before, and the amendment serves no purpose whatever. This was quite a material amendment to the statute, and it should not be nullified, and the terms of the statute formerly existing restored, by judicial construction. The change in the effect and operation of a statute to the extent of the change in the language thereof must be recognized and applied by the court. County Board of Education of Hancock Co. v. Boehm, 102 Ohio St., 292. We have no question here of failure to use, or abandonment of the use of, the trade mark privileges or of the rights conferred; nor have we a situation where there is any claim of any prior right on the part of those

to whom labels were being furnished by the defendant under the registration act.

It is our opinion that the purpose and effect of this statute was to project the trade-mark rights of the registrant and owner thereof into all the states even in advance of the establishment of trade therein, and to afford full protection to such registrant and owner.

The provisions of the act of 1905 so interpreted and applied are not violative of the Federal Constitution, but are authorized by Section 8 of Article I thereof, wherein power is conferred upon Congress "to regulate commerce with foreign nations, and among the several states, and with the Indian tribes." There is ample ground for the contention that the purpose of the passage of the act of 1905 was to put trade-marks on the same basis as patents, and to afford them like protection. In a case involving the construction of Section 9 of the act of 1905 it was said by Chief Justice Taft: "It is obvious from that section and the whole of the Trade-mark Act that Congress intended to produce a parallelism in the mode of securing these two kinds of Government monopoly from the Patent Office." (American Steel Foundries v. Robertson, 262 U. S., 209.) Congress has necessarily taken cognizance of the increased interstate character of trade and commerce, and trademarks would be of little value if protection could not be afforded the registrant thereof by act of Congress, and the method provided falls within the power conferred to regulate such commerce. It was said by Chief Justice White in United States v. Ferger, 250 U. S., 199, a case involving the

power of Congress to regulate commerce, that the power to regulate commerce "must include the authority to deal with obstructions to interstate commerce • • • and with a host of other acts which, because of their relation to and influence upon interstate commerce, come within the power of Congress to regulate, although they are not interstate commerce in and of themselves."

For reasons that are obvious the rule long applied relative to infringers of patents is alike applicable here, and that is that all who actively and intentionally aid and abet the infringing are equally infringers, or, as some of the decisions classify them, contributing infringers. Heaton-Peninsular Button-Fastener Co. v. Eureaka Specialty Co., 77 Fed., 288; Von Mumm v. Wittemann, 85 Fed., 966; Hennessy v. Herrmann, 89 Fed., 669.

Judgment affirmed.

Day, Kinkade and Jones, JJ., concur.

[Certificate attached.]

IN THE COURT OF APPEALS, HAMILTON COUNTY, OHIO.

GRIGGS-COOPER AND COMPANY, A CORPORATION UNDER THE LAWS OF MINNESOTA,

Plaintiff,

vs.

THE UNITED STATES PRINTING AND LITHOGRAPHING COMPANY, A CORPORATION UNDER THE LAWS OF OHIO,

Defendant.

[No. 2913.]

Transcript of Docket and Journal Entries.

1926, April 16. Transcript and original papers filed.

1926, April 20. Motion to suspend operation of injunction filed.

1926, September 14. Three copies of motion for rehearing and brief in support thereof filed.

1926, December 4. Exhibits filed.

1927, March 7. January term. Min. 75. Judgment for plaintiff and decree of injunction against defendant at the cost of defendant.

This cause came on to be heard upon appeal from the Common Pleas Court of Hamilton county, Ohio, was heard upon the pleadings and the stipulation as to facts in issue herein made by the parties hereto and filed herein and was argued by E. H. Morphy of St. Paul, Minnesota,

and Oliver G. Bailey on behalf of the plaintiff and by Walter F. Murray on behalf of the defendant, and was submitted to the court.

Upon consideration whereof the court finds that the plaintiff at the time of filing its petition in said Court of Common Pleas used, and it and its predecessor, Griggs-Cooper and Company, for many years prior thereto had sold various descriptions of groceries, goods, wares and merchandise under the trademark "Home Brand" in Minnesota, Wisconsin, Iowa, North Dakota, South Dakota, and Washington, beyond which states its sales did not extend and applied and had applied said trademark by means of labels containing said words, "Home Brand," and affixed to the packages and containers of said groceries, goods, wares, and merchandise; that from time to time plaintiff and its said precessor caused said trademark as affixed to said divers kinds of said groceries, goods, wares and merchandise to be duly registered under the act of Congress of February 20, 1905, and amendments thereto in the patent office of the United States as provided by the acts of Congress relating thereto, which said registrations were upon the following dates, under and the following numbers and for the following descriptions of groceries, goods, wares and merchandise:

United States trademark "Home Brand," Registration No. 54205, for pickled limes, dated June 19, 1906.

United States trademark "Home Brand," Registration No. 54206, for horseradish cream, dated June 19, 1906.

United States trademark "Home Brand," Registration No. 54207, for capers, dated June 19, 1906.

United States trademark "Home Brand," Registration No. 56111, for olives, dated August 28, 1906.

United States trademark "Home Brand," Registration No. 56112, for jams, marmalade, fruit-butters and jellies, dated August 28, 1906.

United States trademark "Home Brand," Registration No. 56113, for table sauces, dated August 28, 1906.

United States trademark "Home Brand," Registration No. 56132, for candy, dated August 28, 1906.

United States trademark "Home Brand," Registration No. 56133, for vinegar, dated August 28, 1906.

United States trademark "Home Brand," Registration No. 56134, for buckwheat and pancake flour, dated August 28, 1906.

United States trademark "Home Brand," Registration No. 56135, for plum pudding, dated August 28, 1906.

United States trademark "Home Brand," Registration No. 56136, for mincemeat, dated August 28, 1906.

United States trademark "Home Brand," Registration No. 56163, for toast, biscuits, crackers, ginger wafers, graham wafers, chocolate wafers, oatmeat wafers, and other wafers, dated August 28, 1906.

United States trademark "Home Brand," Registration No. 56164, for rice, dated August 28, 1906.

United States trademark "Home Brand," Registration No. 56165, for rolled oats and farina, dated August 28, 1906.

United States trademark "Home Brand," Registra-

tion No. 56166, for vermicelli, spaghetti and macaroni, dated August 28, 1906.

United States trademark "Home Brand," Registration No. 56184, for spices and mustard, dated August 28, 1906.

United States trademark "Home Brand," Registration No. 56211, for fruit coloring, dated September 4, 1906.

United States trademark "Home Brand," Registration No. 56212, for toilet and laundry borax, dated September 4, 1906.

United States trademark "Home Brand," Registration No. 56320, for laundry starch, dated September 11, 1906.

United States trademark "Home Brand," Registration No. 56333, for syrup, honey and sorghum, dated September 11, 1906.

United States trademark "Home Brand," Registration No. 56341, for various named non-alcoholic beverages, dated September 11, 1906.

United States trademark "Home Brand," Registration No. 56351, for flavoring extracts, dated September 18, 1906.

United States trademark "Home Brand," Registration No. 56685, for certain named non-alcoholic beverages, dated October 16, 1906.

United States trademark "Home Brand," Registration No. 57592, for tea, dated November 13, 1906.

United States trademark "Home Brand," Registration No. 57593, for birdseed, dated November 13, 1906.

United States trademark "Home Brand," Registration No. 59103, for pickles and chow-chow, dated January 1, 1907.

United States trademark "Home Brand," Registration No. 59133, for olive oil, dated January 1, 1907.

United States trademark "Home Brand," Registration No. 59194, for glaced fruits and crystallized ginger, dated January 1, 1907.

United States trademark "Home Brand," Registration No. 59309, for salad dressing, dated January 8, 1907.

United States trademark "Home Brand," Registration No. 65696, for tapioca and sago, dated October 15, 1907.

United States trademark "Home Brand," Registration No. 75937, for olive salad and corn starch, dated November 30, 1909.

United States trademark "Home Brand," Registration No. 131989, for canned and preserved fruits, canned vegetables, coffee, etc., dated June 8, 1920.

The court finds that the plaintiff and its predecessor advertised extensively said groceries, goods, wares and merchandise under and by means of said trade-mark "Home Brand" in the territory hereinbefore set forth and had and plaintiff has therein a substantial volume of sales of such groceries, goods, wares and merchandise under said trademark; that the plaintiff is and was at the time of filing its petition in said Court of Common Pleas the owner of said trademark "Home Brand" and of each of said registrations thereof; and the essential feature of the said trademark is and was at all times the

arbitrarily selected word "Home" and that the plaintiff is and was at the time of filing the said petition entitled to the exclusive use in the territory hereinbefore set forth of said trademarks and each of them on the goods of the several descriptions set forth and that the aforesaid registrations under the trademark act of 1905 the rights of the plaintiff in the trademark were extended to cover commerce among the states other than the several states where the trade of the plaintiff has been established.

The court finds that for many years prior to the filing of the petition in the Common Pleas Court the defendant, The United States Printing and Lithographing Company, had printed, published and sold to its customers in the states of Kansas, Illinois, Indiana, Pennsylvania, Missouri, Ohio, Michigan, Virginia, Maryland and Louisiana, certain labels upon which the word "Home" appeared in combination with some word such as "Harvest Home," "Homestead," "Home Wood," "Home Comfort," "Home Town," "Home Club," "Home Run" and others and upon and in the sale of groceries, goods, wares and merchandise similar to those described in said registrations of plaintiff's said trademark "Home Brand" and in which plaintiff dealt under said trademark that plaintiff prior to filing its petition in said Court of Common Pleas, notified defendant in writing of plaintiff's rights under and to the said registered trademark "Home Brand" and demanded that defendant cease to print, publish or sell labels, which were the same or similar to plaintiff's said labels or contained the said trademark "Home Brand" or the distinguishing feature "Home"

or any imitation or simulation thereof, but defendant refused to comply with said demand and claimed and asserts the right to and intends to continue to print, publish and sell such labels.

The court finds that said labels so printed, published and sold by the defendant constitute wrongful infringements of the plaintiff's rights to said trademarks and that plaintiff is entitled to an injunction restraining the defendant from printing, publishing or selling any labels, wrappers or other identifying matter, containing the trademark "Home Brand" or the essential feature thereof "Home" or any simulation or imitation thereof, for the sale of groceries, goods, wares and merchandise of any of the several kinds described in plaintiff's said registered trademarks and restraining the defendant from infringing in any manner plaintiff's rights to its said registered trademarks.

It is therefore ordered, adjudged and decreed by the court that the defendant, The United States Printing and Lithographing Company, a corporation under the laws of Ohio, its agents, servants and employees and each and all of them be and they are hereby perpetually enjoined from printing, publishing or selling any labels, wrappers or other identifying matter containing the trademark "Home Brand" or the essential feature thereof "Home" or any simulation or imitation thereof for the sale of groceries, goods, wares and merchandise of any of the several kinds described in plaintiff's said registered trademarks, and from infringing in any manner plaintiff's rights to its said registered trademark.

It is further ordered that a writ of injunction issue enjoining and restraining the defendant, its agents, servants and employees as aforesaid.

It is further ordered that the defendant pay the costs herein taxed as ($.....) dollars.

To all of which the defendant by its counsel excepts.

[Duly certified.]

MOTION FOR REHEARING.

[Filed September 14, 1926.]

The defendant, The United States Printing and Lithograph Company, hereby makes application for rehearing on motion for suspending operation of the injunction granted by the Court of Common Pleas, and for hearing on the merits and the law applicable to this cause.

There is appended hereto a copy of defendant's brief in support of this motion.

Service of copy of this motion and appended brief has been made upon counsel for plaintiff.

WALTER F. MURRAY,
Attorney for Defendant.

IN THE COURT OF COMMON PLEAS, HAMILTON COUNTY, OHIO.

GRIGGS-COOPER AND COMPANY, A CORPORATION UNDER THE LAWS OF MINNESOTA,

Plaintiff,

vs.

THE UNITED STATES PRINTING AND LITHOGRAPHING COMPANY, A CORPORATION UNDER THE LAWS OF OHIO,

Defendant.

[No. 181590.]

Transcript of Docket and Journal Entries.

1922, April 7. Petition filed.

1922, April 7. Summons issued.

1922, April 17. Summons returned endorsed: Received, Ferd Bader, sheriff, Hamilton county, Ohio, April 7, 2:42 p. m., 1922.

Cincinnati, Ohio, April 10, 1922.

Served the within named defendant, The United States Printing and Lithographing Company, a corporation under the laws of the state of Ohio, by delivering a true copy of this writ with all the endorsements thereon personally to John Omwake, president thereof. Sheriff fees $1.87. Ferd Bader, sheriff, Hamilton county, Ohio. By John Krieg, deputy.

1922, May 6. Demurrer filed.

1923, January 9. Minute 1812. Entry overruling demurrer to petition.

This cause came on to be heard upon the demurrer of the defendant to the plaintiff's petition herein and was argued by counsel and submitted to the court, and the court finds said demurrer not well taken and overrules the same, to which the defendant excepts.

Defendant is granted twenty days from the date hereof to answer said petition.

1923, January 29. Answer filed.

1925, May 28. Stipulation filed.

1926, March 22. Decree of permanent injunction at defendant's costs. Defendant excepts and gives notice of appeal. Appeal bond fixed at $500.00.

1926, April 7. Bond 142 in Bond Book 25 in $500.00 for appeal given. (See safe in clerk's office.)

This cause came on to be heard upon the pleadings and the stipulation as to facts in issue herein, made by the parties hereto and filed herein, and was argued by E. H. Morphy of St. Paul, Minnesota, and Oliver G. Bailey on behalf of the plaintiff and by Miller Outcalt and Walter F. Murray on behalf of the defendant, and was submitted to the court.

Upon consideration whereof the court finds that the plaintiff at the time of filing its petition herein used, and it and its predecessor, Griggs-Cooper & Company, for many years prior thereto had sold various descriptions of groceries, goods, wares and merchandise, under the trademark "Home Brand" in Minnesota, Wisconsin, Iowa, North Dakota, South Dakota and Washington, be-

yond which states its sales did not extend, and applied, and had applied, said trademark by means of labels containing said words "Home Brand" and affixed to the packages and containers of said groceries, goods, wares and merchandise; that from time to time plaintiff and its said predecessor caused said trademarks as affixed to said divers kinds of said groceries, goods, wares and merchandise, to be duly registered under the act of Congress of February 20, 1905, and amendments thereto in the patent office of the United States as provided by the acts of Congress relating thereto, which said registrations were upon the following dates, under the following numbers and for the following descriptions of groceries, goods, wares and merchandise:

United States trademark "Home Brand," Registration No. 54205, for pickled limes, dated June 19, 1906.

United States trademark "Home Brand," Registration No. 54206, for horseradish cream, dated June 19, 1906.

United States trademark "Home Brand," Registration No. 54207, for capers, dated June 19, 1906.

United States trademark "Home Brand," Registration No. 56111, for olives, dated August 28, 1906.

United States trademark "Home Brand," Registration No. 56112, for jams, marmalade, fruit butters and jellies, dated August 28, 1906.

United States trademark "Home Brand," Registration No. 56113, for table sauces, dated August 28, 1906.

United States trademark "Home Brand," Registration No. 56132, for candy, dated August 28, 1906.

United States trademark "Home Brand," Registration No. 56133, for vinegar, dated August 28, 1906.

United States trademark "Home Brand," Registration No. 56134, for buckwheat and pancake flour, dated August 28, 1906.

United States trademark "Home Brand," Registration No. 56135, for plum pudding, dated August 28, 1906.

United States trademark "Home Brand," Registration No. 56136, for mincemeat, dated August 28, 1906.

United States trademark "Home Brand," Registration No. 56163, for toast, biscuits, crackers, ginger wafers, graham wafers, chocolate wafers, oatmeal wafers, and other wafers, dated August 28, 1906.

United States trademark "Home Brand," Registration No. 56164, for rice, dated August 28, 1906.

United States trademark "Home Brand," Registration No. 56165, for rolled oats, and farina, dated August 28, 1906.

United States trademark "Home Brand," Registration No. 56166, for vermicelli, spaghetti and macaroni, dated August 28, 1906.

United States trademark "Home Brand," Registration No. 56184, for spices and mustard, dated August 28, 1906.

United States trademark "Home Brand," Registration No. 56211, for fruit coloring, dated September 4, 1906.

United States trademark "Home Brand," Registration No. 56212, for toilet and laundry borax, dated September 4, 1906.

United States trademark "Home Brand," Registration No. 56320, for laundry starch, dated September 11, 1906.

United States trademark "Home Brand," Registration No. 56333, for syrup, honey and sorghum, dated September 11, 1906.

United States trademark "Home Brand," Registration No. 56341, for various named non-alcoholic beverages, dated September 11, 1906.

United States trademark "Home Brand," Registration No. 56351, for flavoring extracts, dated September 18, 1906.

United States trademark "Home Brand," Registration No. 56685, for certain named non-alcoholic beverages, dated October 16, 1906.

United States trademark "Home Brand," Registration No. 57592, for tea, dated November 13, 1906.

United States trademark "Home Brand," Registration No. 57593, for birdseed, dated November 13, 1906.

United States trademark "Home Brand," Registration No. 59103, for pickles and chow-chow, dated January 1, 1907.

United States trademark "Home Brand," Registration No. 59133, for olive oil, dated January 1, 1907.

United States trademark "Home Brand," Registration No. 59194, for glazed fruits and crystallized ginger, dated January 1, 1907.

United States trademark "Home Brand," Registration No. 59309, for salad dressing, dated January 8, 1907.

United States trademark "Home Brand," Registra-

tion No. 56596, for tapioca and sago, dated October 15, 1907.

United States trademark "Home Brand," Registration No. 75937, for olive salad and corn starch, dated November 30, 1909.

United States trademark "Home Brand," Registration No. 131989, for canned and preserved fruits, canned vegetables, coffee, etc., dated June 8, 1920.

The court finds that the plaintiff and its predecessor advertised extensively said groceries, goods, wares and merchandise under and by means of said trademark "Home Brand," in the territory hereinbefore set forth, and had, and plaintiff has, therein a substantial volume of sales of such groceries, goods, wares and merchandise under said trademarks; that the plaintiff is and was at the time of filing its petition herein, the owner of said trade-mark "Home Brand" and of each of said registrations thereof; that the essential feature of the said trademark is, and was, at all said times, the arbitrarily selected word "Home" and that the plaintiff is and was at the time of filing the said petition, entitled to the exclusive use, in the territory hereinbefore set forth, of said trademarks, and each of them, on the goods of the several descriptions set forth, and that by the aforesaid registrations under the trademark act of 1905, the rights of the plaintiff in the trademark were extended to cover commerce among the states, other than the several states where the trade of the plaintiff has been established.

The court finds that prior to the filing of the petition herein, the defendant, The United States Printing and

Lithographing Company, printed, published and sold to its customers in the states of Kansas, Illinois, Indiana, Pennsylvania, Missouri, Ohio, Michigan, Virginia, Maryland and Louisiana, certain labels upon which the word "Home" appeared in combination with some other word such as "Harvest Home," "Homestead," "Home Wood," "Home Comfort," "Home Town," "Home Club," "Home Run" and others, and upon and in the sale of groceries, goods, wares and merchandise similar to those described in said registrations of plaintiff's said trademark "Home Brand" and in which plaintiff dealt under said trademark; that plaintiff prior to filing its petition herein notified defendant in writing of plaintiff's rights under and to the said registered trademark "Home Brand" and demanded that defendant cease to print, publish or sell labels which were the same, or similar to, plaintiff's said labels, or contained the said trademark "Home Brand," or the distinguishing feature "Home," or any imitation or simulation thereof, but defendant refused to comply with said demand and claimed and asserts the right to, and intends to continue to, print, publish and sell such labels.

The court finds that said labels so printed, published and sold by the defendant constitute wrongful infringements of the plaintiff's rights to said trademarks and that plaintiff is entitled to an injunction restraining the defendant from printing, publishing or selling any labels, wrappers or other identifying matter, containing the trademark "Home Brand" or the essential feature thereof, "Home," or any simulation or imitation thereof, for

the sale of groceries, goods, wares and merchandise of any of the several kinds described in plaintiff's said registered trademarks and restraining the defendant from infringing in any manner plaintiff's rights to its said registered trademarks.

It is therefore ordered, adjudged and decreed by the court that the defendant, The United States Printing and Lithographing Company, a corporation under the laws of Ohio, its agents, servants and employees, and each and all of them be and they are hereby perpetually enjoined from printing, publishing or selling any labels, wrappers or other identifying matter, containing the trademark "Home Brand" or the essential feature thereof "Home," or any simulation or imitation thereof, for the sale of groceries, goods, wares and merchandise of any of the several kinds described in plaintiff's said registered trademarks, and from infringing in any manner plaintiff's rights to its said registered trademarks.

It is further ordered that a writ of injunction issue enjoining and restraining the defendant, its agents, servants and employees as aforesaid.

It is further ordered that the defendant pay the costs herein taxed at ..... dollars ($.....).

To all of which the defendant by its counsel excepts and gives notice of appeal and the court fixes the appeal bond at the sum of five hundred dollars ($500.00).

[Duly certified.]

PETITION.

[Filed April 7, 1922.]

The plaintiff above named is now and has been since on or about the first day of January, 1901, a corporation duly organized, created and existing under and by virtue of the laws of the state of Minnesota, having its principle place of business in the city of St. Paul, in said state; the business of said corporation, ever since its incorporation being that of manufacturing wholesale grocers and the selling of groceries and other like goods, wares and merchandise at wholesale in the state of Minnesota and various other states of the United States and especially within the states of Minnesota, Wisconsin, Michigan, North and South Dakota, Montana and Washington.

The defendant is a corporation duly organized, created and existing under and by virtue of the laws of the state of Ohio, having its principal place of business in the city of Norwood, in said state; the business of said corporation being amongst other things that of printing, lithographing and selling labels to various persons, firms and corporations for use in their business.

For many years prior to the year 1893, Griggs, Cooper & Company was a partnership composed of Chauncey W. Griggs, C. Milton Griggs and Jason W. Cooper, doing business as manufacturing wholesale grocers and the selling of groceries and other like goods, wares and merchandise, at wholesale in the state of Minnesota, and various other state of the United States. The said firm continued doing said business from prior to said date of 1893 and up to the said first of January, 1901, when said firm became incorporated as aforesaid.

Upon the incorporation of the plaintiff as aforesaid, the said firm of Griggs, Cooper and Company, for a valuable consideration duly sold, assigned, transferred and set over to the plaintiff corporation, all of the business and the entire assets of said firm including all of the right, title and interest of, in and to certain trademarks hereinafter more particularly referred to, then owned and controlled by said firm, together with the good will in the business of said co-partnership identified thereby, and the trademark "Home Brand" hereinafter referred to, as well as said other assets, became legally and absolutely vested in the said plaintiff corporation, and have so remained vested in the said plaintiff corporation from said date up to the present time.

From time to time in the transaction of said business the said firm of Griggs, Cooper and Company and its successor, the plaintiff herein, adopted and used the said trademark "Home Brand" for various descriptions of grocers' goods, wares and merchandise sold by them and applied said trademark to such goods, wares and merchandise sold by them on the market in said states of Minnesota, Wisconsin, Michigan, North and South Dakota, Montana, Washington and other states of the United States, and from time to time caused the said trademark as affixed to said divers kinds of such grocers' goods, wares and merchandise to be duly registered in the United States patent office as provided by law, said registration being upon the dates hereinafter set forth and said goods being of the several descriptions recited in said registrations and the application of said mark

to such goods being by the means of labels bearing said trademark "Home Brand," samples of which labels are of record in the respective files of said registrations in the United States patent office.

Plaintiff and its said predecessor, the Griggs, Cooper and Company, at the time of the said registrations and continuously from said time until the present time sold under said name, and using said trademark, said respective goods, wares and merchandise in its said market, to wit, in the states of Minnesota, Wisconsin, Michigan, North and South Dakota, Washington, Montana and other states of the Union. Said registrations are as follows, to wit:

United States trademark "Home Brand," Registration No. 22829, for preserved fruits and vegetables, dated April 18, 1893.

United States trademark "Home Brand," Registration No. 31881, for cheese, spices, extracts, maple syrup, sorghum, molasses, salt, teas, soda, starch, bluing, wet mustard, farinaceous foods, pickles, olive oil, salad dressings, jellies, sauces, macaroni, vermicelli, birdseed, dried fruits and vinegar, dated April 16, 1898.

United States trademark "Home Brand," Registration No. 54205, for pickled limes, dated June 19, 1906.

United States trademark "Home Brand," Registration No. 54206, for horseradish cream, dated June 19, 1906.

United States trademark "Home Brand," Registration No. 54207, for capers, dated June 19, 1906.

United States trademark "Home Brand," Registration No. 56111, for olives, dated August 28, 1906.

United States trademark "Home Brand," Registration No. 56112, for jams, marmalade, fruit-butters and jellies, dated August 28, 1906.

United States trademark "Home Brand," Registration No. 56113, for table sauces, dated August 28, 1906.

United States trademark "Home Brand," Registration No. 56132, for candy, dated August 28, 1906.

United States trademark "Home Brand," Registration No. 56133, for vinegar, dated August 28, 1906.

United States trademark "Home Brand," Registration No. 56134, for buckwheat and pancake flour, dated August 28, 1906.

United States trademark "Home Brand," Registration No. 56135, for plum pudding, dated August 28, 1906.

United States trademark "Home Brand," Registration No. 56136, for mincemeat, dated August 28, 1906.

United States trademark "Home Brand," Registration No. 56163, for toast, biscuits, crackers, ginger wafers, graham wafers, chocolate wafers, oatmeal wafers, and other wafers, dated August 28, 1906.

United States trademark "Home Brand," Registration No. 56164, for rice, dated August 28, 1906.

United States trademark "Home Brand," Registration No. 56165, for rolled oats, and farina, dated August 28, 1906.

United States trademark "Home Brand," Registration No. 56166, for vermicelli, spaghetti and macaroni, dated August 28, 1906.

United States trademark "Home Brand," Registration No. 56184, for spices and mustard, dated August 28, 1906.

United States trademark "Home Brand," Registration No. 56211, for fruit coloring, dated September 4, 1906.

United States trademark "Home Brand," Registration No. 56212, for toilet and laundry borax, dated September 4, 1906.

United States trademark "Home Brand," Registration No. 56320, for laundry starch, dated September 11, 1906.

United States trademark "Home Brand," Registration No. 56333, for syrup, honey and sorghum, dated September 11, 1906.

United States trademark "Home Brand," Registration No. 56341, for various named non-alcoholic beverages, dated September 11, 1908.

United States trademark "Home Brand," Registration No. 56351, for flavoring extracts, dated September 18, 1906.

United States trademark "Home Brand," Registration No. 56685, for certain named non-alcoholic beverages, dated October 16, 1906.

United States trademark "Home Brand," Registration No. 57592, for tea, dated November 13, 1906.

United States trademark "Home Brand," Registration No. 57593, for birdseed, dated November 13, 1906.

United States trademark "Home Brand," Registration No. 59103, for pickles and chow-chow, dated January 1, 1907.

United States trademark "Home Brand," Registration No. 59133, for olive oil, dated January 1, 1907.

United States trademark "Home Brand," Registration No. 59194, for glazed fruits and crystallized ginger, dated January 1, 1907.

United States trademark "Home Brand," Registration No. 59309, for salad dressing, dated January 8, 1907.

United States trademark "Home Brand," Registration No. 65696, for tapioca and sago, dated October 15, 1907.

United States trademark "Home Brand," Registration No. 75937, for olive salad and corn starch, dated November 30, 1909.

United States trademark "Home Brand," Registration No. 131929, for canned and preserved fruits, canned vegetables, coffee, etc., dated June 8, 1920.

The essential feature of the said trademark is and was at all said times the arbitrarily selected word "Home" and said word "Home" in association with the word "Brand" was so used by the said plaintiff, and its said predecessor, Griggs, Cooper and Company, upon the labels on said products sold by them in substantially the manner shown in the samples of said labels which are hereto attached and marked "Exhibits One, Two, Three and Four" respectively and made a part hereof.

The plaintiff and its said predecessor have sold said respective goods, wares and merchandise under the said trademark "Home Brand" in its said market ever since the said dates of the said respective registrations and plaintiff is still selling said goods in such manner in said states and plaintiff and its predecessor have expended large sums of money in acquiring and maintaining its

said trademark "Home Brand," and in advertising the goods sold by it under and in connection with said trademark and by reason of the said sales and said advertising and expenses so incurred by the plaintiff and its predecessor the said trademark "Home Brand" has become widely known as the property of the plaintiff and widely and favorably known to the public as identifying the products of the plaintiff and distinguishing them from those of all other dealers in similar lines of said goods, wares and merchandise and plaintiff has built up a large and lucrative business in said goods, wares and merchandise, and the public is in the habit of identifying such goods, wares and merchandise with the word "Home" as a trademark, whether with or without other distinguishing matter, as originating with the plaintiff corporation, and confusion in the mind of the public and damage to the plaintiff corporation will be caused by printing, publishing and selling any labels in which the word "Home" appears when applied to any goods, wares and merchandise of the same kind and class which are being sold by the plaintiff corporation under its said trademark of "Home Brand" as aforesaid.

The defendant is now and has been for some time past printing, publishing and selling numerous labels in which the word "Home" appears for all kinds of commodities usually sold by manufacturing grocers and wholesale grocers including the above described goods, wares and merchandise sold by the plaintiff corporation as aforesaid under the said registered trademark "Home Brand" and the labels in relation thereto. The labels containing

or bearing the word "Home," so printed, published and sold by the defendant as aforesaid are used by the purchasers from said defendant as a trademark or mark in the sale by them in the same territory in which plaintiff and its said predecessor established their market and have long sold their said products, and said purchasers thereby sell goods, wares and merchandise in said territory of the same kinds respectively as those dealt in by plaintiff under said trademark and the labels so printed, published and sold by the defendant as aforesaid are as defendant well knew sufficiently similar to the plaintiff's said trademark "Home Brand" as to lead to confusion and mistake in the minds of the public and purchasers and said acts of the defendants are knowingly done with the effect of enabling its purchasers by the use of such labels to substitute and palm off their goods, wares and merchandise of the plaintiff to the irreparable damage of the plaintiff for which it has no adequate remedy at law.

Immediately on the plaintiff corporation becoming aware of the fact that the defendant was printing, publishing and selling said labels as aforesaid plaintiff on or about November 17, 1921, and December 21, 1921, notified defendant in writing of its rights under and to said trademark and demanded of the defendant that it desist from said infringements thereof but defendant has refused to comply with the said demand and insists upon the right to, and continues to print, publish and sell said labels as aforesaid with full knowledge of the rights of said plaintiff as aforesaid and of the fact that by such printing, publishing and selling said labels it

enables and abets its purchasers in infringing upon plaintiff's rights in the said trademark and unless restrained by an order of this Honorable Court the defendant will continue to print, publish and sell said labels as aforesaid and by reason thereof the business of the plaintiff and its reputation and patronage and good will in and about its business will be seriously and irreparably injured; for which the plaintiff has no adequate remedy at law.

Wherefore, plaintiff prays that the defendant, its agents, servants and employees, and each and all of them be enjoined and restrained temporarily until the determination of this action and permanently thereafter from printing, publishing or selling labels for any kind of grocery commodities such as are being sold by the plaintiff as aforesaid in which label the word "Home" appears, for its costs and all other proper relief.

COBB, HOWARD & BAILEY,
MORPHY, BRADFORD & CUMMINS,
Attorneys for Plaintiff.

[Duly verified.]

ANSWER.

[Filed January 29, 1923.]

The defendant above named, admits that plaintiff is a corporation, is domiciled and has a business such as alleged in the first paragraph of the petition.

Defendant admits that it is a corporation and has a business as alleged in the second paragraph of the petition.

Defendant admits the truth of the allegation concerning the business of plaintiff's predecessor and that any

rights to the trademark "Home" which were owned by plaintiff's predecessor, were assigned to plaintiff.

Defendant admits that plaintiff and its predecessor used the words "Home Brand" upon various descriptions of grocers' goods, in the states specified in the fourth paragraph of the petition and that plaintiff secured from the United States patent office the certificates of registration set forth upon pages 3, 4 and 5 of the petition.

Defendant denies that the essential feature of the trademarks in said certificates was the word "Home" and that the word "Home", was arbitrarily selected.

Defendant denies that the word "Home" has become widely known as the trademark property of the plaintiff, and that confusion in the mind of the public and damage to the plaintiff will be caused by defendant's printing, publishing and selling labels on which the word "Home" appears, for application to grocers' goods.

Defendant admits that it has in the past, printed and sold labels on which the word "Home" appeared, for various commodities sold by grocers, but defendant denies that it has printed, published and sold labels bearing the word "Home", with a knowledge that their use by defendant's customers would lead to confusion and mistake in the minds of the public, and that the printing, publishing and selling of said labels has enabled its customers to substitute and palm off their goods as the goods of the plaintiff, or to the damage of the plaintiff.

Defendant admits that plaintiff notified defendant of its alleged rights and demanded that defendant dis-

continue printing, publishing and selling said labels, but alleges plaintiff did not afford defendant any evidence that any of the lebals it was printing were being used by its customers illegally.

Defendant alleges that at great expense to itself, it has compiled a list of trademarks of all kinds of goods and that are registered and in use; that it is its practice before filling an order for labels from a customer, to examine this list and to refuse to print labels that seem to conflict plainly with the rights of merchants other than said customer, but it is impractical for defendant to institute searches to determine conflicting rights, before filling its orders for labels.

Defendant alleges, upon information and belief that there are large numbers of persons, in various states of the United States, that have a right to use labels, bearing the word "Home", upon their canned goods and that defendant has a right to print the labels for the persons, aforesaid.

Defendant alleges that the United States patent office has issued a large number of certificates of registration of trademarks for foods and comprising the word "Home", to various registrants, that are domiciled in various states of the United States, and that defendant has a right to print labels for canned goods and containing the word "Home", for the use of these registrants.

Wherefore, defendant prays that the petition be dismissed, for its costs and other proper relief.

The United States Printing & Lithograph Co.,
By MILLER OUTCALT and
WALTER F. MURRAY,
Its Attorneys.

[Duly verified.]

STIPULATION.

[Filed May 28, 1925.]

Griggs, Cooper and Company, plaintiff herein, and The United States Printing & Lithographing Company, defendant herein, by their respective counsel, hereby agree as to the following facts in issue in the above entitled case and stipulate that this agreement may be used on the trial of said case in lieu of evidence as to such facts, to wit:—

(A) That the defendant, The United States Printing & Lithographing Company, had, prior to the filing of the petition in this action, printed, published, and sold the labels, true copies of which are hereto attached, numbered consecutively as exhibits from one to twenty-three, made a part hereof, and that the names of the parties to whom such labels were sold, the dates of sale and the place of business of such purchasers, are as follows:—

Name and Address	Trade-Mark	Goods
Jett & Wood Grocer Co., Wichita, Kans.	Harvest Home	Oysters
P. Hohenadel Jr. Canneries Co., Gray Lake, Ills.	Nu Home	Peas
Hohenadel-Stocking Packing Co., Rochelle, Ills.	Newhome	Peas, Sweetcorn
Tuhey Canning Co., Muncie, Ind.	Homestead	Peas
The Jett & Wood Merc. Co., Wichita and Hutchinson, Kans.	Harvest Home	Cherries
Franklin MacVeagh & Co., Chicago, Ills.	Homewood	Grapes
The Rath Mfg. Co., Philadelphia, Pa.	Homestead	Furniture Polish
Donnell Mfg. Co., St. Louis, Mo.	Home Comfort	Laundry Bluing
J. T. Scott & Co., River Forest, Ills.	Home Club	Relish
The Albert F. Remy Co., Mansfield, Ohio.	Home Guard	Green Stringless Beans
Michigan State Cannery, Jackson, Michigan.	Home Grown	Peas
Ed. Fuhr, Republic, Mo.	Home Pack	Tomatoes

Edward M. McCormick, Reeds Spring, Mo.	Homestead	Tomatoes
Old Homestead Canning Co., Fork Union, Va.	Old Homestead	Tomatoes
F. I. Mease, Reeds Spring, Mo.	Homestead	Tomatoes
Mullison-Economy Stores, Wilkes Barre, Pa.	Home Brand	Mince Meat
F. G. Davis Co., Lewiston, Maine,	Home Town	Mince Meat
Zschunke Bros., Baltimore, Md.	Home Pride	Cake
Federal Cigarette and Tobacco Co., Montreal, Can.	Home	Cigarettes
Florodora Tag Co., New Orleans, La.	Home Run	Tobacco

(B) That the labels, bound in book form and numbered consecutively as exhibits 1 to 85 inclusive, are true and correct copies of the labels used by the plaintiff herein in the sale of its goods and registered by it in the United States patent office as alleged in plaintiff's petition herein, and that under such labels subsequent to the respective dates of such registration in the states of Minnesota, Wisconsin, Iowa, North Dakota, South Dakota, Montana and Washington.

The plaintiff and its predecessors have advertised said goods by the labels set forth in the stipulation herein extensively in the territory herein set forth, and are still selling goods under said labels, and have therein a large and substantial volume of sales of said goods under said labels.

(C) That at the time of the commencement of this action the territory in which the plaintiff sold and had been selling its commodities as set forth in the petition herein under the registered trademark "Home Brand" was and is in the following states, to wit: Minnesota, Wisconsin, Iowa, North Dakota, South Dakota, Montana and Washington, and did not extend beyond said territory, but such stipulation as to plaintiff's territory is without prejudice to the claim of the plaintiff that in law it has the right to be protected in the use of such registered trademarks in all of the states of the United States and particularly in any additional territory in which it may hereafter sell products under such trademarks, and that its customers are retail grocers, located in the aforesaid states.

(D) That the following are brand names containing the word "Home," the names and addresses of the merchants who have used them, the class of goods upon which they have been used, and the dates and numbers of registrations thereof in the United States patent office, viz.:

Name and Address.	Trade-Mark.	Goods.	U. S. Registration Date and No.
Ogden Baking Company, Ogden, Utah	Home of Delight	Bread	July 19, 1921, No. 144,908
Wm. H. Bruning, Evansville, Ind.	Home Drip	Coffee	Dec. 14, 1920, No. 138,170
F. A. Bower, Boston, Mass.	Home Favorite	Coffee	July 3, 1906, No. 12,981
Washburn Crosby Co., Minneapolis, Minn.	A Home Favorite	Flour	Dec. 27, 1904, No. 1166
Ward Baking Co., New York, N. Y.	Homelike	Bread	May 4, 1915, No. 104,163
Waxtwell Paper Co., Grand Rapids, Mich.	Home Made	Bread	Feb. 7, 1922, No. 24,023
S. B. Stone, New Haven, Conn.	Home Made "S"	Jellies	April 16, 1907, No. 62,080
W. W. Devore, Cincinnati, Ohio	Home Maid	Coffee	May 25, 1920, No. 131,735
Northwestern Elevator & Mill Co., Toledo and Loudenville, Ohio	Home Plate	Wheat Flour	May 3, 1910, No. 78,199
Julius Rumpel, Weston, Mo.	Home Pride	Flour	Sept. 14, 1920, No. 22,136

Name and Address.	Trade-Mark.	Goods.	U. S. Registration Date and No.
Reid, Murdock & Fisher, Chicago, Ills.	Home Rule	Wheat Flour	Dec. 14, 1886, No. 13,879
The Acme Mills, Hopkinsville, Ky.	Home Run	Self Rising Wheat Flour	June 8, 1920, No. 131,949
Fisher Flouring Mills Co., Seattle, Wash.	Home Run	Wheat Flour	Aug. 16, 1921, No. 145,665
Wm. Wrigley, Jr., Co., Chicago, Ills.	Home Run	Chewing Gum	Sept. 29, 1914, No. 100,067
Steinwender Stroffregen Coffee Co., St. Louis, Mo.	Homeseeker	Roasted Coffee	June 15, 1915, No. 104,810
Great West Mill & Elevator Co., Amarillo, Texas	Homeseeker	Wheat Flour	Nov. 8, 1921, No. 148,421
Ward Baking Co., New York, N. Y.	Homespun	Bread	April 19, 1921, No. 141,460
C. A. Hammond & Co., Bazile Mills, Nebr.	Home Stake	Flour	Jan. 11, 1887 No. 13,970
Homestead Growers Assn., Homestead, Fla.	Homestead	Fresh Tomatoes	Jan. 3, 1922, No. 150,410
Michael & Sons, Oakington, Md.	Homestead	Canned Corn	May 2, 1893, No. 22913
Jones Brewing Co.,	Homestead	Ale	Feb. 18, 1902,

London, England			
Fussell Ice Cream Co., New York, N. Y.	Home Treat	Ice Cream and Water Ices	No. 37,816 Dec. 14, 1915,
C. D. Kenny Co., Baltimore, Md.	Home Wood	Coffee	No. 107,608 Oct. 26, 1915,
C. D. Kenny Co., Baltimore, Md.	Home Wood	Coffee	No. 106,624 April 13, 1915,
Home Yeast Cakes, Chicago, Ills.	Home Yeast Cakes	Yeast	No. 18,372 Jan. 11, 1887,
Gerhard Lang, Buffalo, N. Y.	Home of Pure Foods	Fresh Meats consisting of Beef, Lamb, Veal and Pork; Smoked Meats consisting of Ham, Bacon, Tongue, and Dried Beef; Salted Meats consisting of Corned Beef, Salted Tongue and Lard	No. 5081 June 28, 1921, No. 144,325
Nutricia Dairy Farm Products Co., Thiensville, Wis.	Farm to Home	Canned Peas	Jan. 25, 1916, No. 108,259

Name and Address.	Trade-Mark.	Goods.	U. S. Registration Date and No.
Memphis Bread Co., Memphis, Tenn.	Happy Home	Bread	Sept. 6, 1921, No. 23,374
Wulfing Gro. Co., St. Louis, Mo.	Happy Home	Chemicals, Cream of Tartar, Castor Oil, Alum, Ammonia, Camphor, Insect Powder, Moth Balls, Salpeter, Epsom Salts, Sulfur	April 21, 1914, No. 96,560
Memphis Bread Co., Memphis, Tenn.	Happy Home	Bread and Cake	July 12, 1921, No. 144,607
St. Elmo Milling Co., St. Elmo, Ills.	Happy Home	Wheat Flour	Nov. 9, 1920, No. 136,949
Matson Coffee Co., Salt Lake City, Utah	Mountain Home	Coffee	May 4, 1915, No. 18,428
Washburn Crosby Co., Minneapolis, Minn.	Old Home	Wheat Flour	Aug. 10, 1920, No. 133,943

C. C. Boney, Minneapolis, Minn.	Old Home and figure of woman standing before house blowing a horn	Wheat Flour	Nov. 18, 1902, No. 39,318
Vogel Bros. & Co., St. Louis, Mo.	Our Home Comfort	Coffee	June 13, 1905, No. 12,201
Geo. Blome & Son Co., Baltimore, Md.	Old Homestead and figure of house	Candy Cough Drops	July 21, 1914, No. 98471
Paducah Vinegar Wks., Paducah, Ky.	Old Homestead Cider and figure of log house	Cider	Oct. 15, 1907, No. 65,683
Bennett, Sloan & Co., New York, N. Y.	The Old Homestead	Canned Meats, Fish, Fruits, Spices, Condiments and Veg. except Corn	March 6, 1894, No. 24,301
S. J. Valk & Bro., New York, N. Y.	Old Homestead and figure of log cabin	Syrup, comp. of Maple Sugar, Syrup and Cane Sugar, Syrup	Jan. 17, 1911, No. 80,688
Price & Lucas Cider & Vinegar Co., Louisville, Ky.	Old Homestead	Vinegar	June 11, 1907, No. 63,288
Hecker Jones Milling Co.,	Old Homestead	Flour	June 4, 1895,

Name and Address.	Trade-Mark.	Goods.	U. S. Registration Date and No.
New York, N. Y.			No. 26,648
G. J. Blome, Baltimore, Md.	The Old Homestead	Cough Lozenges	Dec. 4, 1894, No. 25,579
W. J. Meikelham, Cohoes, N. Y.	Old Homestead	Bread, Biscuits, Cakes and Crackers	Oct. 11, 1892, No. 21,861
Jos. Breck & Sons, Boston, Mass.	Old Homestead	Popcorn	Oct. 17, 1899, No. 7176
C. E. Hires Co., Philadelphia, Pa.	Old Homestead	Condensed Milk	Aug. 1, 1899, No. 7074
T. A. Sheffield & Co., New York, N. Y.	Sheffield's Old Homestead Java and Mocha Coffee	Coffee	Oct. 18, 1904, No. 11,487
E. M. Clough, Chicago, Ills.	Original Old Homestead	Pudding Sauce	Sept. 19, 1899, No. 7136
E. Cripp & Son, Louisville, Ky.	Old Kentucky Home Flour	Wheat Flour	June 30, 1891, No. 19,795
Fred Johnson, De Ridder, La.	Southern Home	Bread and Cake	May 14, 1918, No. 121,626
Larkin & Co., Buffalo, N. Y.	Sweet Home	Washing Compound	Sept. 9, 1870, No. 7666

Plaut Milling Co., St. Louis, Mo.	Sweet Home	Wheat Flour	Jan. 10, 1899, No. 32,361
New Orleans Coffee Co., New Orleans, La.	Sweet Home and figure of baby lying in scale	Molasses, Syrup and Sorghum	Aug. 2, 1904, No. 43,112
Steinwender Stroffregen Coffee Co., St. Louis, Mo.	Home Circle	Roasted Coffee	May 23, 1916, No. 110,438
Wm. C. Roberson, New York, N. Y.	Home Comfort	Wheat Flour	March 12, 1912, No. 85,767
J. Stiner, New York, N. Y.	Home Comfort	Baking Powder	April 30, 1878, No. 5966
W. H. Roberson, New York, N. Y.	Home Comfort	Flour	Nov. 1, 1891, No. 8805
A. F. Remy Co., Mansfield, Ohio	Home Guard	Canned Fruits, Fish, Oysters, Catsup and Soup	April 4, 1893, No. 22,742
A. F. Remy Co., Mansfield, Ohio	Home Guard	Canned Fruits, Fish, Vegetables, Meats, Oysters, Catsup and Soup	May 9, 1893, No. 23,015
Ward Baking Co., New York, N. Y.	Homelike	Cake	Nov. 9, 1920, No. 136,979

Name and Address.	Trade-Mark.	Goods.	U. S. Registration Date and No.
Homelike Canning & Packing Co., San Francisco, Calif.	Homelike	Canned Fish	March 16, 1915, No. 103,000
W. R. Grace & Co., New York, N. Y., and San Francisco, Calif.	Homelike	Canned Fruits	Aug. 10, 1920, No. 133,981
Garden City Canning Co., Philadelphia, Pa.	Homelike Dinners	Lamb Stew	Feb. 1, 1921, No. 22,467
Geo. Haas & Sons, San Francisco, Calif.	Home Made Specials	Foods and ingredients of Food, Candies	May 17, 1921, No. 142,871
Home Maid Products Co., New York, N. Y.	Home Maid	Chili Sauce and Marmalade	June 15, 1915, No. 104,727
G. Rousis, San Francisco, Calif.	Home Run	Pop Corn Crisps	March 7, 1922, No. 152,974
Seacoast Canning Co., Eastport, Me.	Home Run and figure of ball players	Sardines	Aug. 20, 1912, No. 88,122
Thos. P. Deitrick, Richmond, Va.	Homespun	Canned Fruits and Vegetables, Spices, Lard, Cornmeal, Oat	July 7, 1914, No. 98,258

		Flakes, Pickles, Olives, Catsup, Vinegar, Syrup, Coffee, Herring, Macaroni, Flour, Tea	
Schwabacher Bros. & Co., Seattle, Wash.	Happy Home	Canned Fish	April 17, 1906, No. 61,389
Hull & Dillon Pkg. Co., Pittsburgh, Kans.	Old Homestead	Ham, Bacon, Lard	July 16, 1912, No. 87,452
W. Roes, Baltimore, Md.	Sweet Home	Bread and Cakes	Nov. 7, 1899, No. 33,693
New Orleans Coffee Co., New Orleans, La.	Sweet Home	Molasses, Syrup and Sorghum	Nov. 7, 1905, No. 47,529
F. G. C. Schnor, Sioux City, Iowa	Home Made	Sausage	July 31, 1906, No. 1742
D. B. Austin, Grand Rapids, Mich.	Old Home	Bread	April 17, 1900, No. 7485
E. M. Clough, Chicago, Ills.	Old Homestead	Plum Pudding	Oct. 18, 1898, No. 6700
Happy Home Breakfast Food Co., Niagara Falls, N. Y.	Happy Home Breakfast Food	Breakfast Food	Oct. 3, 1916, No. 19636

Plaintiff does not concede that the matters set forth in Article D have any relevancy or competency in this cause.

COBB, HOWARD & BAILEY,
Counsel for Plaintiff.
WALTER F. MURRAY,
Counsel for Defendant.

Cincinati, Ohio,
March 11, 1924.

SUPREME COURT.
STATE OF OHIO.

I, Seba H. Miller, clerk of the Supreme Court of the state of Ohio, do hereby certify that the foregoing is a true and correct copy of the record and proceedings in the case of The United States Printing and Lithograph Company v. Griggs-Cooper and Company, No. 20435, and of the whole thereof, as the same remains upon the files and records of said Supreme Court of the state of Ohio.

In testimony whereof, I have subscribed my name and affixed the seal of said court at the city of Columbus, Ohio, this twenty-seventh day of July, 1928.

[Seal.] Seba H. Miller,
Clerk of the Supreme Court of the State of Ohio.

SUPREME COURT OF THE UNITED STATES

ORDER ALLOWING CERTIORARI—Filed October 22, 1928

The petition herein for a writ of certiorari to the Supreme Court of the State of Ohio is granted. And it is further ordered that the duly certified copy of the transcript of the proceedings below which accompanied the petition shall be treated as though filed in response to such writ.

FILED
AUG 17 1928
CHARLES ELMORE CROPLEY
CLERK

Supreme Court of the United States

OCTOBER TERM, 1928

No. 372

THE UNITED STATES PRINTING AND LITHOGRAPH COMPANY,

Petitioner,

vs.

GRIGGS, COOPER AND COMPANY.

PETITION FOR WRIT OF CERTIORARI—BRIEF

FRANK F. DINSMORE,
WALTER F. MURRAY,
Counsel for Petitioner.

Supreme Court of the United States

OCTOBER TERM, 1928

No. .....

THE UNITED STATES PRINTING AND LITHOGRAPH COMPANY,

Petitioner,

vs.

GRIGGS, COOPER AND COMPANY.

PETITION FOR WRIT OF CERTIORARI

May it please the Court:

The petition of The United States Printing and Lithograph Company respectfully shows to this Honorable Court:

That the Supreme Court of the State of Ohio found that

I. The plaintiff had used its trade-mark "Home Brand" prior to and since the year 1901, upon groceries, in Minnesota, Wisconsin, Iowa, North Dakota, South Dakota, Montana and Washington. (Rec., p. 8);

II. The plaintiff conceded that its trade did not extend beyond these states (Rec., p. 12);

III. The plaintiff had registered its trade-mark "Home Brand" in the United States Patent Office under the trade-mark Act of 1905 (Rec., p. 9);

IV. The defendant (petitioner) for many years had printed labels on which the word "Home" appeared in combinations such as "Harvest Home," "Homestead," "Home Town," etc., and had sold them to its customers, who were grocers, located in states to which plaintiff's trade did not extend, namely, Kansas, Illinois, Indiana, Pennsylvania, Missouri, Ohio, Michigan, Virginia, Maryland and Louisiana (Rec., p. 8);

V. "The purpose and effect of the statute" (trade-mark Act of 1905) "was to project the trade-mark rights of the registrant and owner thereof into all the states even in advance of the establishment of trade therein, and to afford full protection to such registrant and owner." • • • and • • • "There is ample ground for the contention that the purpose of the passage of the Act of 1905 was to put trade-marks on the same basis as patents, and to afford them like protection." (Rec., p. 16.)

The Court's attention is called to the fact that, though seven Justices sat in the case, three only concurred in this ruling. (Rec., p. 17.)

VI. The judgment finding plaintiff entitled to an injunction against defendant's printing said labels for its customers, is affirmed. (Rec., p. 17.)

REASONS ADVANCED FOR ALLOWING THE WRIT

The Supreme Court of Ohio in deciding that registration of a trade-mark under the trade-mark act of 1905, projects the right of the registrant into states, in which he had done no business and in advance of his trade, has decided a

federal question of substance not theretofore determined by this Court, and in a way probably not in accord with the decisions of this Court, in considering earlier trade-mark statutes.

WHEREFORE, your petitioner respectfully prays that a writ of certiorari be issued out of and under the seal of this Honorable Court, directed to the Supreme Court of the State of Ohio, commanding that Court to certify and to send to this Court for its review and determination, on a day certain to be therein named, a full and complete transcript of the record and all proceedings in the case numbered and entitled on its docket, No. 20435, The United States Printing and Lithograph Company, plaintiff in error, vs. Griggs, Cooper and Company, defendant in error, and that the said judgment of the Supreme Court of the State of Ohio may be reversed by this Honorable Court, and that your petitioners may have such other and further relief in the premises as to this Honorable Court may seem meet and just; and your petitioners will ever pray.

THE UNITED STATES PRINTING AND
LITHOGRAPH COMPANY,
By FRANK F. DINSMORE,
WALTER F. MURRAY,
Counsel for Petitioner.

Supreme Court of the United States

THE UNITED STATES PRINTING AND LITHOGRAPH COMPANY,

Petitioner,

vs.

GRIGGS, COOPER AND COMPANY.

BRIEF

This case was decided by the Supreme Court of Ohio upon June 20, 1928. (Rec., p. 6.)

The opinion is printed at page 7 of the Transcript of Record.

The ruling made therein, which is relied upon as the basis of the Court's jurisdiction, is that the effect of the United States Trade-Mark Act of 1905 "was to project the trade-mark rights of the registrant and owner thereof into all the states, even in advance of the establishment of trade therein, and to afford full protection to such registrant and owner." (Rec., p. 16.)

The effect of this ruling is that a grocer who had sold his goods under the name "Home" solely in the north-western states, by securing registration of the word in the Patent Office, could prevent grocers, who had been selling their goods under names such as "Harvest Home" and "Home Run," in states remote from the north-western states, from getting labels printed for use on their goods, under their trade-marks.

This Court has decided how trade-mark rights are created, and what the powers of Congress, over these rights are, but has not had before it, the specific question, as to whether the Trade-Mark Act of 1905 extended the trade-mark rights of a registrant into states in advance of the extension of the trade therein. It is thought, however, that the decisions of this Honorable Court, in construing earlier trade-mark acts, indicate that the Trade-Mark Act of 1905 can not have the effect given to it by the Supreme Court of Ohio in this case.

This Court has decided that:

A

The property in trade-marks and the right to their exclusive use rest on the laws of the states. In Trade-Mark Cases, 100 U. S. at page 93, Mr. Justice Miller said:

> "The property in trade-marks and the right to their exclusive use resting on the laws of the states in the same manner that other property does, and depending, like the great body of the rights of person and of property, for their security and protection on those laws, the power of Congress to legislate on the subject, to establish the conditions on which these rights shall depend, the period of their duration, and the legal remedies for their protection, if such power exist at all, must be found in some clause of the Constitution of the United States, the instrument which is the source of all the powers that Congress can lawfully exercise."

B

That trade-mark rights, resting on the laws of the states, are limited to states in which the trade-marks are used.

Hanover Star Milling Co. v. *Metcalf*, 240 U. S. 403.

In *Hanover Star Milling Co.* v. *Metcalf*, 240 U. S. at page 425, Mr. Justice Holmes (concurring) said:

> "The question then is, what is the common law of Alabama in cases like these? It appears to me that if a mark previously unknown in that state has been used and given a reputation there, the state may well say that those who have spent their money innocently in giving it its local value are not to be defeated by proof that others have used the mark earlier in another jurisdiction more or less remote."

In *United Drug Co.* v. *Rectanus Co.*, 248 U. S. at page 100, Mr. Justice Pitney said:

> "Property in trade-marks and the right to their exclusive use rest upon the laws of the several states, and depend upon them for security and protection; the power of Congress to legislate upon the subject being only such as arises from the authority to regulate commerce with foreign nations and among the several states and with Indian tribes. (Page 98.) • • •
>
> It would be a perversion of the law of priority to give it such an application in our broadly extended country, that an innocent party, who had in good faith employed a trade-mark in one state, and by use of it had built up a trade there, being the first appropriator in that jurisdiction, might afterwards be prevented from using it with consequent injury to his trade and good-will at the instance of one who theretofore had employed the same mark, but only in other and remote jurisdictions, upon the ground that its first employment happened to antedate that of the first mentioned trader."

C

That Congress has been given no right to legislate upon the substantive law of trade-marks.

Trade-Mark Cases, 100 U. S. 93.
American Steel Foundries v. *Robertson*, 269 U. S. 372.

In *Trade-Mark Cases,* 100 U. S. 93, speaking of the United States Trade-Mark Act of 1870, Mr. Justice Miller said at page 96:

> "There still remains a very large amount of commerce, perhaps the largest, which, being trade or traffic between citizens of the same state, is beyond the control of Congress.
>
> When, therefore, Congress undertakes to enact a law, which can only be valid as a regulation of commerce, it is reasonable to expect to find on the face of the statute, or from its essential nature, that it is a regulation of commerce with foreign nations, among the several states, or with the Indian tribes. If it is not so limited, it is in excess of the power of Congress. If its main purpose be to establish a regulation applicable to all trade; to commerce at all points, especially if it is apparent that it is designed to govern the commerce wholly between citizens of the same state, it is obviously the exercise of a power not confided to Congress."

And in *Hanover Star Milling Co.* v. *Metcalf,* Mr. Justice Pitney said at page 416, 240 U. S.

> "And so far as the controversy concerns intrastate distribution as distinguished from interstate trade, the subject is not within the sovereign powers of the United States."

It is submitted that the ruling of the Supreme Court of Ohio, that registration under the Trade-Mark Act of 1905 extends the rights of the registrant into states in which registrant has done no business, is not in accord with decisions of this Court classified above under headings A, B and C.

CONCLUSION

It is respectfully submitted that this case is one that calls for the exercise by this Court of its supervisory power in order that the question as to whether registration under the 1905 Trade-Mark Act creates rights of the registrant in states in which he has done no business, may be authoritatively decided, and that to such an end a writ of certiorari should be granted and that this Court should review the decision of the Supreme Court of Ohio and reverse it.

Respectfully,

FRANK F. DINSMORE,
WALTER F. MURRAY,
Counsel for Petitioner.

FILED
FEB 4 1928

In the Supreme Court of the United States

OCTOBER TERM, 1928

No. 372

THE UNITED STATES PRINTING AND LITHOGRAPH COMPANY,
Petitioner,

vs.

GRIGGS-COOPER AND COMPANY,
Respondent.

BRIEF ON BEHALF OF PETITIONER

FRANK F. DINSMORE,
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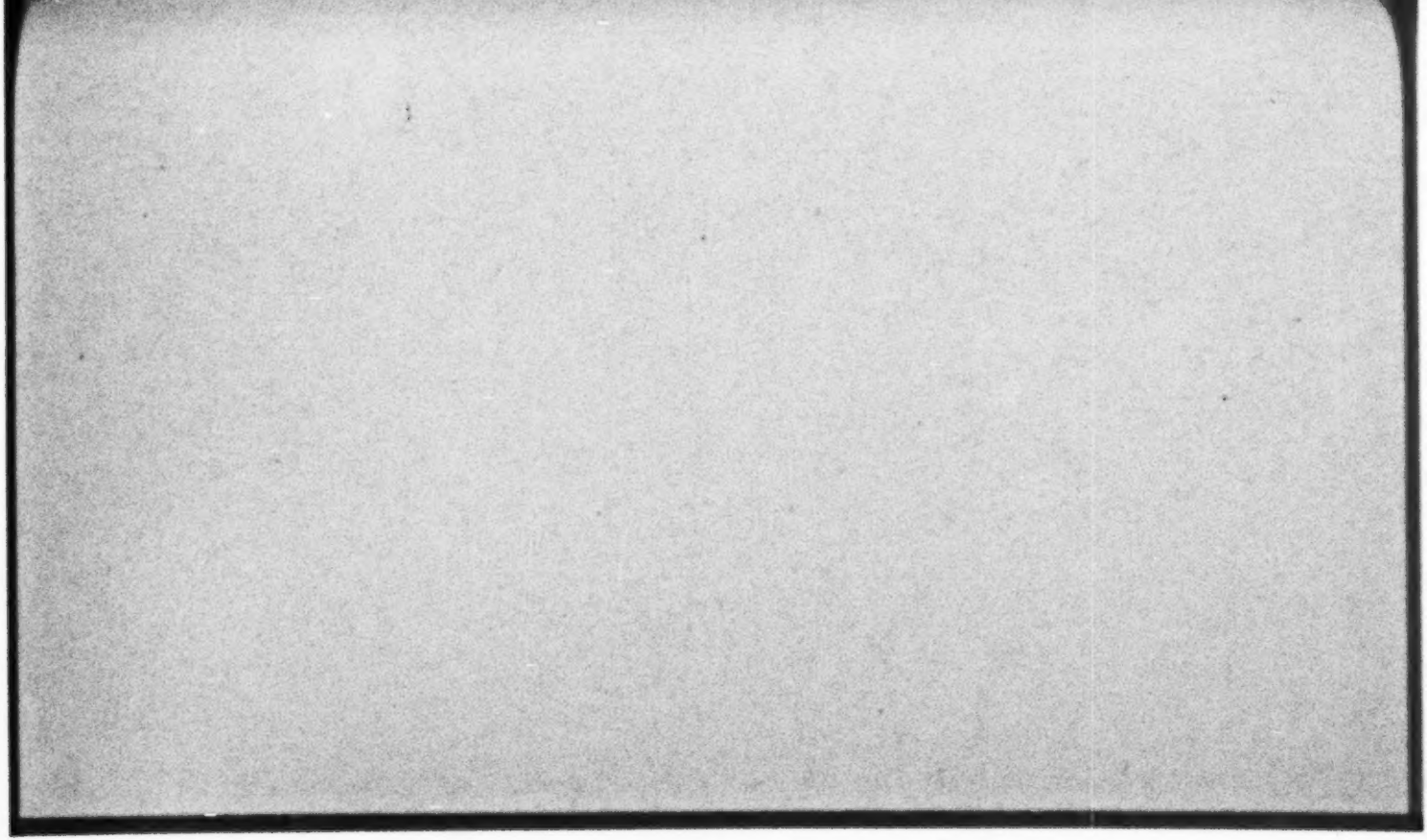

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In the Supreme Court of the United States

OCTOBER TERM, 1928

No. 372

THE UNITED STATES PRINTING AND LITHOGRAPH COMPANY,

Petitioner,

vs.

GRIGGS-COOPER AND COMPANY,

Respondent.

BRIEF ON BEHALF OF PETITIONER

STATEMENT

This case, which comes before this Court pursuant to a writ of certiorari issued to the Supreme Couurt of Ohio, was brought by the Respondent, Griggs-Cooper and Company in the Common Pleas Court of Hamilton County, Ohio, against the Petitioner, The United States Printing & Lithograph Company, for alleged infringement of a trade-mark "Home" for groceries.

The writ was applied for and granted for the reason that the decision of the Supreme Court of Ohio was rendered in favor of Respondent, upon the ground that regis-

tration by the Respondent of the trade-mark "Home" in the United States Patent Office under the Trade-Mark Act of 1905, extended the rights of the Respondent therein, into states, in which the Respondent had not done business, under the trade-mark. (R. p. 10.)

Respondent's trade under the trade-mark "Home" had been in certain specified states and Petitioner for many years had sold labels bearing trade-marks, comprising the word "Home," to its customers, grocers located in states other than those in which Respondent had sold its goods. The states in which Respondent sold its goods under the trade-mark "Home" were Minnesota, Wisconsin, Iowa, North Dakota, South Dakota, Montana and Washington. The states in which Petitioner's customers for said labels were located were Kansas, Illinois, Indiana, Pennsylvania, Missouri, Ohio, Michigan, Virginia, Maryland and Louisiana. (R. pp. 7 and 8.)

The Supreme Court of Ohio quoted Section 16 of the Trade-Mark Act of 1905, viz:

> "The registration of a trade-mark under the provisions of this subdivision of this chapter shall be *prima facie* evidence of ownership. Any person who shall, without the consent of the owner thereof, reproduce, counterfeit, copy, or colorably imitate any such trade-mark and affix the same to merchandise of substantially the same descriptive properties as those set forth in the registration, or to labels * * * intended to be used upon or in connection with the sale of merchandise of substantially the same descriptive properties as those set forth in such registration, and shall use, or shall have used, such reproduction, counterfeit, copy, or colorable imitation in commerce among the several states, or with a foreign nation, or with the Indian tribes, shall be liable to an action for damages therefor at the suit of the owner thereof." (R. p. 14.)

and construed it as follows:

> "It is our opinion that the purpose and effect of this statute was to project the trade-mark rights of the registrant and owner thereof into all the states even in advance of the establishment of trade therein, and to afford full protection to such registrant and owner.
>
> The provisions of the act of 1905 so interpreted and applied are not violative of the Federal Constitution, but are authorized by Section 8 of Article I thereof, wherein power is conferred upon Congress 'to regulate commerce with foreign nations, and among the several states, and with the Indian tribes.' There is ample ground for the contention that the purpose of the passage of the act of 1905 was to put trade-marks on the same basis as patents, and to afford them like protection." (R. p. 16.)

The Court therefore affirmed the decision that enjoined Petitioner from printing labels for its said customers.

ASSIGNMENT OF ERRORS

It is intended to urge:

1. That the Supreme Court of Ohio erred in holding that the Registration of Respondent's Trade-Mark in the United States Patent Office under the Trade-Mark Act of 1905, extended Respondent's rights in the trade-mark into states in which it had made no sales, and in advance of its trade in those states.

2. That the Supreme Court of Ohio erred in holding that the Registration of Respondent's trade-mark in the United States Patent Office under the Trade-Mark Act of 1905, extended Respondent's rights in the trade-mark into states in which it had made no sales, in advance of its trade in those states, and in derogation of the rights of others, who were first to use the trade-mark in the sale of their goods in those states.

SUMMARY

The effect of this ruling of the Supreme Court of Ohio is that a grocer who had sold his goods under the name "Home" solely in the north-western states, by securing registration of the word in the Patent Office, could prevent grocers who were selling their goods under names such as "Harvest Home" and "Home Run," in states remote from the north-western states, from getting labels printed for use on their goods, under their trade-marks.

ARGUMENT

This Court has decided how trade-mark rights are created, and what the powers of Congress over these rights are, but has not had before it the specific question as to whether the Trade-Mark Act of 1905 extended the trade-mark rights of a registrant into states in advance of the extension of the trade therein. It is thought, however, that the decisions of this Honorable Court, in construing earlier trade-mark acts, indicate that the Trade-Mark Act of 1905 can not have the effect given to it by the Supreme Court of Ohio in this case.

This Court has decided that:

A.

The property in trade-marks and the right to their exclusive use rest on the laws of the states. In *Trade-Mark Cases*, 100 U. S., at page 93, Mr. Justice Miller said:

> "The property in trade-marks and the right to their exclusive use resting on the laws of the states in the same manner that other property does, and depending like the great body of the rights of person and of property for their security and protection on those laws, the power of Congress to legislate on the subject to establish the conditions on which these rights

shall depend, the period of their duration, and the legal remedies for their protection, if such power exist at all, must be found in some clause of the Constitution of the United States, the instrument which is the source of all the powers that Congress can lawfully exercise."

B.

Trade-mark rights, resting on the laws of the states, are limited to states in which the trade-marks are used.

In *Hanover Star Milling Company* v. *Metcalf*, 240 U. S. at page 425, Mr. Justice Holmes (concurring) said:

> "The question then is, what is the common law of Alabama in cases like these? It appears to me that if a mark previously unknown in that state has been used and given a reputation there, the state may well say that those who have spent their money innocently in giving it its local value are not to be defeated by proof that others have used the mark earlier in another jurisdiction more or less remote."

In *United Drug Co.* v. *Rectanus Co.*, 248 U. S. at page 100, Mr. Justice Pitney said:

> "Property in trade-marks and the right to their exclusive use rest upon the laws of the several states, and depend upon them for security and protection; the power of Congress to legislate upon the subject being only such as arises from the authority to regulate commerce with foreign nations and among the several states and with Indian tribes. (Page 98.) • • •
>
> It would be a perversion of the law of priority to give it such an application in our broadly extended country, that an innocent party, who had in good faith employed a trade-mark in one state, and by use of it had built up a trade there, being the first appropriator in that jurisdiction, might afterwards be prevented from using it with consequent injury to his trade and good-will at the instance of one who theretofore had

employed the same mark, but only in other and remote jurisdictions, upon the ground that its first employment happened to antedate that of the first mentioned trader."

C.

Congress has been given no right to legislate upon the substantive law of trade-marks.

In *Trade-Mark Cases*, 100 U. S. 93, speaking of the United States Trade-Mark Act of 1870, Mr. Justice Miller said at page 96:

> "There still remains a very large amount of commerce, perhaps the largest, which, being trade or traffic between citizens of the same state, is beyond the control of Congress.
>
> When, therefore, Congress undertakes to enact a law which can only be valid as a regulation of commerce, it is reasonable to expect to find on the face of the statute, or from its essential nature, that it is a regulation of commerce with foreign nations, among the several states, or with the Indian tribes. If it is not so limited, it is in excess of the power of Congress. If its main purpose be to establish a regulation applicable to all trade, to commerce at all points, especially if it is apparent that it is designed to govern the commerce wholly between citizens of the same state, it is obviously the exercise of a power not confided to Congress."

In *Hanover Star Milling Co.* v. *Metcalf*, Mr. Justice Pitney said at page 416, 240 U. S.:

> "And so far as the controversy concerns intrastate distribution as distinguished from interstate trade, the subject is not within the sovereign powers of the United States."

It is submitted that the ruling of the Supreme Court of Ohio that registration under the Trade-Mark Act of 1905

extends the rights of the registrant into states in which registrant has done no business, is not in accord with decisions of this Court above classified under headings A, B and C.

The point of law in issue has been decided in a way opposite to that of the Supreme Court of Ohio by United States Circuit Court of Appeals and by United States District Courts.

In *General Baking Company* v. *Gorman*, 3 Fed. Rep. 2nd, 893-894, the plaintiff had registered its trade-mark under the Trade-Mark Act of 1905. Plaintiff's contention that its rights were thereby projected in advance of its trade was answered by the United States Circuit Court of Appeals of the First Circuit, thus:

> "Plaintiff's learned counsel contend that the federal registration of its trade-mark in 1916 gave it a practically unlimited right of expansion, so that local bakers were thereafter charged with knowledge of its purpose to introduce in their communities "Bond" bread, and were therefore prevented from adopting any trade-name which might conceivably infringe upon the "Bond" trade-mark. This contention, on analysis, falls little short of making federal registration of a trade-mark the equivalent of a patent or a copyright —a far-reaching proposition we can not adopt. Nothing is better settled than that rights in trade-marks are of common-law origin, and are always 'apurtenant to an established business or trade in connection with which' they are employed. See *Trade-Mark Cases*, 100 U. S. 82, 25 L. ed. 550; *Ainsworth* v. *Walmsley*, L. R. 1 Eq. 518, 524. Rhode Island can not be deprived of the power to protect its citizens in the good will of their business by federal registration of a trade-mark for interstate commerce."

That registration confers no rights that the registrant did not have under common law is thus stated by Judge

Learned Hand in *Waldes* v. *International Mfrs. Agency*, 237 Fed. Rep. 502-506:

> "Registration confers no right, and limits none; it is a mere procedural advantage, depending upon common-law 'ownership,' which can exist quite as well without it."

A similar finding by Chief Justice Smyth of the Court of Appeals of the District of Columbia, is found in *Robertson, Commissioner of Patents*, v. *United States, ex rel., Baldwin Co.*, 287 Fed. Rep. 943, viz:

> "Registration of a mark conveys no property right * * * and its cancellation takes none away. Ownership of the mark depends upon its adoption and use, not on its registration. * * * The only effect of registration is to raise a rebuttable presumption in favor of the registrant's ownership."

In *Andrew Jergens Co.* v. *Woodbury*, 273 Fed. Rep. 952, at page 965, Judge Morris said:

> "The complainant caused a combination mark consisting of the word 'Woodbury's' and the neckless head, to be registered for use upon some of the commodities which it claims through the assignment of the trustee dated March 6, 1909; but under the facts of this case such registration neither conferred any greater rights in the use of that name or mark upon the complainant, nor diminished the rights of others entitled to the use thereof."

In *Ammon & Person* v. *Narragansett Dairy Company*, Judge Anderson, in the United States Court of Appeals of the First Circuit, 262 Fed. Rep. 880, said at page 881:

> "While the plaintiff had registered 'Queen' as its trade-mark, we agree with the court below that the case must be determined on common-law principles and that no rights now in question have been acquired out of registration."

CONCLUSION

We submit that the rights of the Respondent in the trade-mark "Home" are limited by the boundaries of the states in which it has sold its goods thereunder, were not extended into the states in which it had made no sales, that Petitioner in printing and selling labels bearing the trade-mark "Home" to grocers in the states last mentioned, did not infringe any trade-mark rights of the Respondent, and that the decree enjoining Petitioner from such printing and selling should be reversed.

Respectfully submitted,

FRANK F. DINSMORE, and
WALTER F. MURRAY,
Of Counsel for Petitioner.

Office Supreme Court, U.
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In the Supreme Court of the United States

OCTOBER TERM, 1928

No. 372

THE UNITED STATES PRINTING & LITHOGRAPH COMPANY,

Petitioner,

v.

GRIGGS-COOPER & COMPANY,

Respondent.

REPLY BRIEF OF PETITIONER.

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In the Supreme Court of the United States

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Respondent.

REPLY BRIEF OF PETITIONER.

Respondent in its brief undertakes to sustain the judgment of the Supreme Court of Ohio not only for the reasons set forth by that court in its opinion (Record 7), but for the further reason that the customers for whom the petitioner printed labels had sold their products in the same territory in which the respondent was engaged in business.

It is claimed (respondent's brief 2 and 3) that the original petition in the trial court alleged that the labels published and sold by the petitioner to its customers were used by such customers as a trade mark in the sale by them of their goods in the same territory in which the respondent

sold its goods, to-wit, in the States of Minnesota, Wisconsin, North and South Dakota, Montana and Washington. It is claimed that the answer of the petitioner in the trial court did not put in issue this allegation.

In the first place, petitioner contends that the allegation of the petition, which is referred to, was put in issue. The answer denies that petitioner had printed, published and sold labels bearing the word "home," with the knowledge that their use by its customers would lead to confusion and mistake in the minds of the public, and that the printing, publishing and selling of said labels had enabled its customers to substitute and palm off their goods as the goods of the petitioner, or to the damage of the respondent (Record 43). This was the only denial that petitioner could have made. It was being charged as a contributory infringer, and it would have been necessary, in order to make it a contributory infringer, to show that it had sold these labels with a knowledge that they were to be used in infringement of the respondent's trade mark.

The stipulation which the parties entered into (Record 45) does not contain any statement of fact in support of the averment of the petition, now relied on by respondent. The stipulation (Record 48) states that the respondent was selling its commodities in the States of Minnesota, Wisconsin, Iowa, North Dakota, South Dakota, Montana and Washington, and that its trade did not extend beyond said territory. It further stipulates (Record 45) that the petitioner printed, published and sold labels, true copies of which were attached, and the names of the parties to whom the labels were sold and their places of business are set out on pages 46 and 47 of the Record; none of them are in the States in which the respondent does business.

The point now sought to be raised in this court by the respondent in order to sustain the judgment, apparently was not raised in any of the courts of Ohio, so far as this

record is concerned. The decree of the Court of Common Pleas of Hamilton County, Ohio, which was the trial court, is found on pages 27 to 33 inclusive of the Record. It contains a finding of the facts on which its decree is based. It was found by the court in this decree that the trade of the respondent did not extend beyond the States of Minnesota, Wisconsin, Iowa, North Dakota, South Dakota and Washington (Record 27). It was also found that this petitioner printed, published and sold to its customers, in certain other States, labels upon which the word "home" appeared in combination with some other word, but there is no finding that the customers, to whom petitioner sold labels, had sold their goods in any of the States in which the respondent was selling its goods (Record 32). The court further found (Record 31) that the respondent was, at the time of the filing of its petition, entitled to the exclusive use of its trade mark not only in the territory in which it was selling its goods, but "by the aforesaid registrations under the Trade Mark Act of 1905 the rights of the plaintiff in the trade mark were extended to cover commerce among the States, other than the several States where the trade of the plaintiff has been established." This was the rule of law on which the judgment of the trial court was founded.

In the Court of Appeals (an intermediate court in Ohio) to which the case was taken, the final judgment and decree also contains a finding of facts and of the proposition of law, above referred to, in practically the same language as the trial court (Record 18 to 25). There is no finding in that court that the customers, to whom the petitioner had sold labels, had sold their goods in the same territory as the respondent, and that court did not base its judgment on such facts. That court likewise found that under the Trade Mark Act of 1905, the rights of the respondent in this case were extended to cover commerce among the

States other than the several States where its trade had been established (Record 23).

In the Supreme Court of Ohio the judgment entry (Record 6) affirms the judgment of the Court of Appeals. The opinion of the court sets forth the facts, as they were understood by the court, and also the propositions of law that were determined (Record 7 to 17). Respondent's claim that the labels sold by petitioner, as aforesaid, are used by its purchasers in the sale of goods by them in the same territory in which respondent sold its products, conflicts with this statement in the opinion of the court, viz., "However, it is not disclosed whether the commodities of the business concerns to whom the defendant furnishes said labels, and the plaintiff's goods, bearing its label, are sold in the same market." (Record 12.)

The case throughout was tried upon the sole question of whether the rights of the respondent in its trade marks were extended by virtue of the Trade Mark Act of 1905 into States in which it had made no sales and in advance of its trade in those States (Record 16).

The respondent now seeks to claim that the judgment of the Ohio courts was right even though the reasons may be wrong, but the case which the respondent now seeks to make in this court, insofar as the point is concerned, was not the case which the Ohio courts had before them and decided.

We submit, therefore, that in the state of the record the sole question before this court is the one decided by the Supreme Court of Ohio in its opinion and argued in our original brief.

Respectfully submitted,

Frank F. Dinsmore and Walter F. Murray,
Of Counsel for Petitioner.

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Supreme Court of the United States

OCTOBER TERM, 1928.

NO. 372

THE UNITED STATES PRINTING & LITHOGRAPHING COMPANY,
Petitioner,

vs.

GRIGGS COOPER & COMPANY,
Respondent.

BRIEF OF GRIGGS COOPER & COMPANY, RESPONDENT, IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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Supreme Court of the United States

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Respondent.

BRIEF OF GRIGGS COOPER & COMPANY, RESPONDENT, IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

MAY IT PLEASE THIS COURT:

Griggs Cooper & Company, a corporation, Respondent, respectfully presents to this Honorable Court this brief in opposition to the granting of the Writ of Certiorari, as prayed for by Petitioner, on the following grounds:

I.

The Petitioner neglects to quote to this Honorable Court the section 16 of the Trade Mark Act of 1905, upon which the decision of the Court below was founded. This section reads as follows:

"UNITED STATES TRADE MARK ACT OF 1905.

"SEC. 16. That the registration of a trade mark under the provisions of this act shall be prima facie evidence of ownership. Any person who shall, without the consent of the owner thereof, reproduce, counterfeit, copy, or colorably imitate any such trade mark and affix the same to merchandise of substantially the same descriptive properties as those set forth in the registration, or to labels, signs, prints, packages, wrappers, or receptacles intended to be used upon or in connection with the sale of merchandise of substantially the same descriptive properties as those set forth in such registration, and shall use, or shall have used, such reproduction, counterfeit, copy, or colorable imitation in commerce among the several States, or with a foreign nation, or with the Indian tribes, shall be liable to an action for damages therefor at the suit of the owner thereof; and whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment therein for any sum above the amount found by the verdict as the actual damages, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs."

We respectfully submit:

(a) The above section gives to Griggs Cooper & Company, Respondent, protection all over the United States in interstate commerce, regardless of the extension of trade.

(b) The Act of 1905 places trade marks and patents on a similar basis regarding monopoly.

(c) Congress has power, under the constitution, to create trade mark rights, and as held by the Supreme Court of Ohio does hold that section not unconstitutional.

II.

The trade mark cases referred to by Petitioner (p. 6) have no bearing on the question before this Honorable Court, as is evidenced by the concluding words of the opinion:

> "In what we have here said, we wish to be understood as leaving the whole question of the treaty making power of the general government and the duty of Congress, to pass any laws necessary to carry such treaties into effect, *untouched*."
>
> 100 U. S. 82, 25 L. Ed. 550.

III.

The case of

> Hanover Star Milling v. Metcalf, 240 U. S. 402, 60 L. Ed. 713

(cited by counsel p. 5), has nothing to do with the question before this Honorable Court, for it was decided according to common law principles of general application, none of the parties having registered the trade mark in question in that case under any act of Congress or under the laws of any state.

IV.

The same remarks apply to the Rectanus Co. case, (cited by counsel p. 6):

> United Drug Co. v. Rectanus Co., 248 U. S. 90, 63 L. Ed. 141, 39 Sup. Ct. R. 48.

This Honorable Court in this case was considering the question from the standard of the common law and the Act of 1881

(Chap. 138, 21 Stat. L. 502). This act was superseded by the Act of Feb. 20, 1905.

9 Fed. Stats. Ann. 748,

and held squarely that Sec. 16 of the Act of 1905 was not in the case in the following language:

> "The Act of Feb. 20, 1905, which took the place of the Act of 1881 while extending protection to trade marks used in interstate commerce, does not enlarge the effect of previous registrations unless renewed under the provisions of the twelfth section, which was not done in this case, hence we need not consider whether anything in this case would aid the petitioner's case."

It was further said in this case that a trade mark confers no monopoly whatever in a proper sence, but merely a mark or symbol and then used this important language on page 51 Sup. Ct. Reports:

> "It results that the adoption of a trade mark does not, at least in the absence of some valid legislation for the purpose, project the right of protection in the advance of the extension of trade or operate as a claim of territorial rights over areas into which it thereafter may be deemed desirable to extend the trade."

And it is conceded by the Petitioner that this court did not have before it a situation involving the registration of a trade mark under the Act of 1905 (Record p. 13).

We respectfully submit that the act in question was passed to clarify the situation relating to trade marks and give trade marks their proper place in the "commerce" of the nation, and is the "valid legislation" referred to in the above quotation.

V.

The record in the present case does not present the question as to the rights of local users as described in the Hanover Milling Co. case and the Rectanus case, because the statute gives Griggs Cooper & Company, the *prima facie* right, and the Petitioner failed to prove that there were any local users who had commenced their business and built up their trade prior to the registration of the trade marks of Griggs Cooper & Co., and the burden was on the Petitioner to prove such an exception to our prima facie case.

VI.

The provisions of the Act do not violate the Constitution, but are authorized by Section 8, Article 1 wherein power is conferred upon Congress "to regulate commerce with foreign nations and among the several states and with the Indian tribes" (Rec. p. 16).

And the rights of local users are subject to the paramount authority vested in Congress by the Constitution.

VII.

Such results are no more drastic or extensive than in the case of

Louisville & Nashville R. Co. v. Mottley, 219 U. S. 467

and we respectfully refer to the case of

U. S. v. Ferger, 250 U. S. 199, 55 L. Ed. 297

where this Court said (page 302 L. Ed.):

> "The provision in the constitution does not, as we believe, exclude congress from legislating with regard to contracts of the above nature, *while in the exercise of its constitutional right to regulate commerce among the several states*,—(the italics are the court's), and further,—

"anything which directly obstructs and thus regulates the commerce which is carried on among the states whether it is state legislation or private contracts between individuals or corporations, ***should be subject to the power of congress in the regulation of that commerce.***" (The italics are ours.)

And we respectfully refer to the remarks of His Honor Chief Justice Taft, in a case involving the construction of Section 9 of the Act of 1905:

American Steel Foundries v. Robertson, 262 U. S. 209,

"It is obvious from that section and the whole of the Trade Mark Act, that Congress intended to produce a parallelism in the mode of securing these two kinds of Government monopoly from the patent office" (Rec. p. 16).

The rule long applied relative to infringers of patents is alike applicable in the case at bar, and to quote from the decision appealed from:

"That is that all who actively and intentionally aid and abet the infringing are equally infringers,"—citing cases (Rec. p. 17).

The opinion of Mr. Justice Matthias is respectfully referred to (Rec. p. 7).

We submit that the petition for a Writ of Certiorari be denied.

Respectfully,

E. HOWARD MORPHY,
St. Paul, Minn.,

OLIVER G. BAILEY,
Cincinnati, Ohio,
Counsel for Respondent.

Office Supreme Court,
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IN THE

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OCTOBER TERM, 1928.

No. 372.

THE UNITED STATES PRINTING AND LITHOGRAPHING COMPANY,
Petitioner,

vs.

GRIGGS, COOPER & COMPANY,
Respondent.

BRIEF OF RESPONDENT.

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Respondent.

BRIEF OF RESPONDENT.

STATEMENT OF FACTS.

A proper consideration of the issues requires that the statement of facts in petitioner's brief be somewhat enlarged.

The respondent, a Minnesota corporation, is engaged in the business of manufacturing and selling wholesale groceries and other like goods and merchandise in the States of Minnesota, Wisconsin, North and South Dakota, Montana and Washington. Its principal place of business is in the State of Minnesota.

The petitioner is an Ohio corporation engaged in printing, lithographing and selling labels to various persons, firms and corporations to be attached to their various products and for use in their various businesses (Record page 34).

The respondent and its predecessor from the year 1893 up to the present time has used continuously the trademark "Home Brand" upon its grocery products and the articles of merchandise manufactured and sold by it in the above territory. The trademark "Home Brand", covering various commodities manufactured and sold by said respondent, was from time to time registered in the United States Patent Office under the Acts of Congress. There are thirty-four such registrations covering practically all of the articles manufactured and sold by respondent (Record page 35).

The essential feature of respondent's trademark is the arbitrarily selected word "Home" which is associated with the word "Brand". The manner and form of using this trademark upon respondent's products is shown by respondent's labels (Record page 39). The petitioner was not actually engaged in the sale of products similar to those of respondent, but did print, lithograph and sell to its customers various labels which were printed in the State of Ohio and shipped by it to its customers in the States as shown by the stipulation between the parties (Record pages 45-47).

None of the petitioner's labels were sold by it to customers located in the States in which respondent carries on its business. Respondent's petition in the trial court alleges:

> "The labels containing or bearing the word 'Home' so printed, published and sold by the defendant as aforesaid are used by the purchasers from said defendant as a trademark or mark in the sale by them in the same territory in which plaintiff and its said predecessor established

their market and have long sold their said products, and said purchasers thereby sell goods, wares and merchandise in said territory of the same kinds respectively as those dealt in by plaintiff under said trademark and the labels so printed, published and sold by the defendant as aforesaid are as defendant well knew sufficiently similar to the plaintiff's said trademark 'Home Brand' as to lead to confusion and mistake in the minds of the public and purchasers and said acts of the defendants are knowingly done with the effect of enabling its purchasers by the use of such labels to substitute and palm off their goods, wares and merchandise of the plaintiff to the irreparable damage of the plaintiff for which it has no adequate remedy at law."

The answer of the petitioner in the trial court does not put in issue the above allegation. It therefore stands admitted. The respondent and its predecessor advertised its goods bearing the registered trademark extensively in the territory in which respondent was engaged in business and said respondent is still selling goods under said labels and has in said territory a large and substantial volume of sales of goods under said labels (Record page 48).

Respondent in its petition prayed for an injunction restraining and enjoining the petitioner from printing, publishing or selling labels for any kind of grocery commodities such as are being sold by the respondent under its trademark (Record page 42).

The case was tried by the Court of Common Pleas of Hamilton County, Ohio, and a formal order for judgment in favor of respondent was made and entered on April 7th, 1926. Outside of the formal order for judgment no separate and specific findings of fact were made by the trial court (Record pages 26-33).

Thereafter the matter came on for hearing and reargument before the Court of Appeals for Hamilton County, Ohio, wherein the decision of the trial court was affirmed (Record pages 18-25).

The Supreme Court of the State of Ohio issued a writ of error to the Court of Appeals of Hamilton County and the case was reviewed by the Supreme Court and the judgment of the Court of Appeals affirmed (Record pages 4-17). No formal, definite or specific findings of fact or bill of exceptions were before the Supreme Court of Ohio. No request for findings was ever made by petitioner. The case was tried and submitted in all courts upon the pleadings and the stipulation of the parties.

ARGUMENT.

The facts in this case are covered by the undenied averments of the petition, the admissions in the answer and the stipulation of the parties.

Respondent alleges in its petition that the labels printed and prepared by petitioner are used by petitioner's customers as a trademark in the sale by them of their goods and products of the same kind and character as respondent's goods in the same territory in which respondent transacts its business and has established its market. These allegations are material. The petitioner does not deny the same in its answer and it therefore stands admitted. The effect to be given the pleadings in this case is to be determined by the laws of the State of Ohio.

> Robertson v. Perkins, et al., 129 U. S. 233, 32 L. Ed. 686;
> Deputron v. Young, 134 U. S. 241, 33 L. Ed. 923.

In these cases it was decided that material allegations in the complaint, not denied by the answer, stand admitted.

In the case of

> Bomberger v. Turner, 13 Ohio St. 263,

the Court said,

> "In order to put plaintiff upon proof of a material averment in his petition, the defendant must, in some form, deny its truth. Hence, where the answer to such averment is merely 'these defendants do not admit, etc.', the plaintiff cannot be required to offer proof in regard to it."

The law is well stated as to the effect of the pleadings in Aleshire v. P. C. C. & St. L. Railroad Company, 25 Ohio N. P. N. S. 76, as follows:

"Under our practice and that of the common law, a specific denial of one or more allegations of a petition is held to be an admission of all others well pleaded; this conclusion essentially results from the rule that a specific denial to each allegation of a petition is a separate denial applicable only to the specific allegations controverted."

No findings of fact were made by the Court upon the facts admitted in the pleadings nor was such a finding necessary.

In

Fenske v. Nelson, 74 Minn. 1,

the Court said:

"Findings of Fact must be fairly construed with reference to the pleadings and the manifest intention of the trial court. It is not necessary to include in such findings facts admitted by the pleadings."

The rule seems to be settled by the authorities that it is not necessary for the Court to make findings as to matters admitted or not denied in the pleadings.

Goodyear Rubber Co. v. Eureka, 135 Cal. 613, 67 Pac. 1043;

Murphy v. Pacific Bank, 130 Cal. 542, 62 Pac. 1059;

Grossini v. Perazzo, 66 Cal. 545, 6 Pac. 450;

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Alderson v. Cutting, 163 Calif. 503; Anno. Cases 1914 A 1;

Allen v. Hollingshead, 155 Ind. 178, 57 N. E. 917;

Carlisle v. Mulhern, 19 Mo. 56;

State v. Rocky Mountain Bell Tel. Co., 27 Mont. 394, 71 Pac. 311;

Anderson v. Alseth, 8 S. D. 240, 66 N. W. 320;

Peterson v. Johnson, 20 Wash. 497, 55 Pac. 932;

Hawkes v. Dodge County Mut. Ins. Co., 11 Wis. 188.

In

O'Reilly, et al. v. Campbell, et al., 116 U. S. 418, 29 L. Ed. 669,

Mr. Justice Field said:

> "But findings are not to be construed with the strictness of special pleadings. It is sufficient if from them all, taken together with the pleadings, we can see enough upon a fair construction to justify the judgment of the Court notwithstanding their want of precision and the occasional intermixture of matters of fact and conclusions of law. Defects of form should be called to the attention of the trial court by the objecting party, and the requisite correction of the findings would seldom be denied."

Sec. 11470 Ohio General Code provides:

> "When questions of fact are tried by the court, its finding may be general for the plaintiff or defendant, unless, with a view of excepting to the court's decision upon questions of law involved in the trial, one of the parties, so requests, in which case, the court shall state in writing the conclusions of fact found separately from the conclusions of law."

A general finding for plaintiff inferable from an order for judgment in his favor imports a finding of all subsidiary facts necessary to that conclusion.

Fisher v. Drew, 247 Mass. 178, 141 N. E. 875, 30 A. L. R. 798.

The record which went from the Court of Appeals to the Supreme Court of Ohio was without separate or specific findings of fact or bill of exceptions. Under the circumstances a presumption arises that the lower court had sufficient evidence before it to sustain the judgment.

Pure Oil Co. v. Kindall, 116 Ohio St. 123.

The respondent sold its products in Interstate Commerce throughout the territory covered by the stipulation of the parties. The petitioner printed and sold its labels bearing a mark which infringed upon the registered trademark of respondent and shipped such labels through the channels of Interstate Commerce to its various customers, whose names and addresses are covered by the stipulation of facts. The customers of the petitioner attached the infringing labels so printed and shipped by petitioner to their respective products of the same kind and nature as those sold by respondent and petitioner's customers shipped and sold their products in the territory throughout which respondent was engaged in business. This brings us to a consideration of the legal questions involved.

I

The Trademark Act of 1905.

Congress under the power vested in it by the Constitution to regulate Interstate Commerce on February 20th, 1905, enacted the "Trade-Mark Law" which is found in 33 Statutes at Large 724. This act by its express terms is made applicable to "commerce among the several states", whereas the Trade-Mark Act of 1881 covered only Trade-Marks used "in foreign commerce or commerce with Indian tribes". Sections 1 to 15 of the Act provide the machinery for registering a trade-mark used in commerce with foreign nations or among the several states or with Indian tribes. Section 16 of the Act makes the registration of a trade-mark under the provisions thereof prima facie evidence of ownership. It also provides that,

> "Any person who shall, without the consent of the owner thereof, reproduce, counterfeit, copy or colorably imitate such trade-mark and affix the same to merchandise

of substantially the same descriptive properties as those set forth in the registration, or to labels, signs, prints, packages, wrappers or receptacles intended to be used upon or in connection with the sale of merchandise of substantially the same descriptive properties as those set forth in such registration and shall use or shall have used such reproduction, counterfeit, copy or colorable imitation in commerce among the several states or with a foreign nation or with the Indian tribes, shall be liable to an action for damages therefor at the suit of the owner thereof."

Section 19 of the Act provides for the granting of injunctive relief to prevent the violation of any right of the owner of a trade-mark registered under the act. Section 19 of the Act provides:

"The several courts vested with jurisdiction of cases arising under the present Act shall have power to grant injunctions, according to the course and principles of equity, to prevent the violation of any right of the owner of a trade-mark registered under this Act, on such terms as the court may deem reasonable; and upon a decree being rendered in any such case for wrongful use of a trade-mark the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby, and the court shall assess the same or cause the same to be assessed under its direction. The court shall have the same power to increase such damages, in its discretion, as is given by section sixteen of this Act for increasing damages found by verdict in actions of law; and in assessing profits the plaintiff shall be required to prove defendant's sales only; defendant must prove all elements of cost which are claimed."

In

American Steel Foundries v. Robertson, 262 U. S. 209, 67 Fed. 953,

the Hon. the Chief Justice said:

> "It is obvious from that Section (Section 9) and the whole of the trade-mark act that Congress intended to produce a parallelism in the mode of securing these two kinds of Government monopoly from the Patent Office."

In

Le Blume Import Co. v. Coty, 2 Circuit, 293 Fed. 344, at page 349,

the Court said:

> "Monopoly given to a valid trade-mark under the laws of the United States is as complete, so far as it goes, as a monopoly created by patent."

Quoting

Bourjois v. Katzel, 260 U. S. 689, 67 L. Ed. 464, in support.

II.

Claim of Respondent.

The respondent's claim for injunctive relief is based upon the Trade-Mark Act in question and upon common law principles. It is the contention of the respondent that the Trade-Mark Act projects the protection afforded by the Act to the owner of registered trade-marks throughout the entire United States in all of the channels of Interstate Commerce in advance of the sale of merchandise bearing the registered trade-mark.

In Standard Brewing Company of Baltimore v. Interboro Brewing Co., (Circuit Court of Appeals, 2nd Circuit) 229 Fed. 543, the Court said:

> "Trade-mark registered under the statutes of the United States is declared upon. The rights which a person ob-

tains by registration of a trade-mark under those statutes are co-terminus with the territory of the United States."

In other words, a registered trade-mark owner actually using the mark in interstate commerce is entitled to protection in interstate commerce against any infringer or contributing infringer where it appears that goods bearing the infringing labels move in the channels of interstate commerce. Section 16 of the Trade-Mark Act specifically gives to the registered Trade-Mark owner such protection. The language of this section condemns the reproducing, counterfeiting, copying or colorably imitating of a trade-mark, and condemns the affixing of the same to merchandise of substantially the same descriptive properties as those covered by the registered mark, and condemns reproducing, counterfeiting, copying and colorably imitating labels, signs, prints, packages, wrappers or receptacles intended to be used upon or in connection with the sale of merchandise of the same descriptive properties as those covered by the registered Trade-Mark, provided that the offending party shall use or shall have used such reproduction, counterfeit, copy or colorable imitation in commerce among the several states.

Did the Acts committed by the defendant which the Court restrained come within the condemnation of the statute? A mere reference to the facts answers the question. The Court decided that the petitioner printed labels which violated the registered trade-mark of the respondent and such offending labels were shipped in interstate commerce and were attached by defendant's customers to articles of merchandise of substantially the same descriptive properties as those covered by respondent's registered trade-mark. The undenied allegations of respondent's petition show that the merchandise of peti-

tioner's customers bearing such infringing labels were sold by such customers in the territory in which respondent was selling its merchandise bearing its registered trade-mark; in other words, were sold and used in interstate commerce. These facts show a violation by petitioner of respondent's registered trade-mark rights and entitled respondent to the injunctive relief provided for by Section 19 of the Act, and also to injunctive relief in equity without regard to the trade-mark act. The acts and conduct of the petitioner constituted a clear common law violation of respondent's legal rights and constituted unfair competition in trade.

Under the circumstances, the common law relied upon by petitioner that a Trade-Mark Act is not projected into territory in advance of trade has no application to the facts in this case, for the reason that the registered trade-mark of respondent was projected by trade into a certain territory in which the customers of the petitioner thereafter engaged in business.

In addition to committing the acts condemned by said Section 16 the petitioner was a common law contributing infringer.

Prior to the commencement of the action the respondent notified the petitioner in writing of its rights as a registered trade-mark owner and demanded of the petitioner that it desist from infringing such rights. The petitioner refused to comply with the demand and insisted upon continuing to print and publish the defendant's labels with full knowledge of defendant's rights (Record page 42).

In the case of Colman v. Crump, 40 N. Y. Sup. 61, 584, affirmed in 70 N. Y. 573, 578, the defendant was enjoined from the manufacture and sale of labels which were colorable imitation of the plaintiff's. The facts were briefly these: Messrs.

Colman were manufacturers of mustard, and, before the commencement of the suit, adopted a trade-mark of the figure of a bull's head, which it affixed to its products. The defendant engraved, printed and sold certain labels to be affixed to packages of mustard. These labels contained the word "Mustard" and the figure of a bull's head and were colorable imitations of the plaintiff's. These labels were sold to dealers in various parts of the United States. An injunction was granted and the Court, affirming the judgment of the Court below, said:

> "A party may have a property interest, that is, an exclusive right to use a name, symbol, or device to distinguish goods, manufactured and sold by him from those manufactured and sold by others. * * * This property right the Courts will protect by injunction and for its invasion the law gives compensation in damages. It is an infraction of that right to print or manufacture or put upon the market for sale and sell for use upon articles of merchandise of the same kind as those upon which it is used by the proprietor any device or symbol which, by its resemblance to the established trade-mark, will be liable to deceive the public. * * * It is not necessary to establish a guilty knowledge or fraudulent intent on the part of the wrongdoer. It is sufficient that the proprietory right of the party and its actual infringement is shown."

In

Carson v. Urg, 39 Fed. 777,

the court held that fraudulent intent will be presumed, and in

Hennessey v. Herrman, (Circuit Court, N. D. Vol.) 89 Fed. 669,

the court announced the rule that all persons in any way connected with the infringement of a trade-mark are responsible to the owner for the injury done to his rights.

The Supreme Court of Ohio applied the principle of contributing infringer to the facts in this case in which it said:

> "that all who actively and intentionally aid and abet the infringers, or, as some of the decisions classify them, contributing infringers."

The theory upon which the Supreme Court of Ohio sustained the decisions of the lower court of that state became immaterial so long as the decision is right upon the facts. Inaccuracy of statement or misconstruction of the law applicable to the facts are not grounds for reversal so long as the judgment is right and sustained by the evidence.

Williams v. Norris, 12 Wheat. 117, 6 L. Ed. 671;

McClung v. Sillimann, 6 Wheat. 598, 6 L. Ed. 340;

Atwood v. Weems, 99 U. S. 193, 25 L. Ed. 471;

Yazoo & M. Valley R. Co. v. Mullins, 249 U. S. 531, 39 Sup. Ct. Rep. 368, 63 L. Ed. 754.

III.

The Purpose of a Trade Mark.

A trade-mark is an agency or instrumentality by which its owner creates a demand for and promotes the sale of his products.

> "A man's right to the continued enjoyment of his trade reputation and the good will that flows from it, free from unwarranted interference by others, is a property right, for the protection of which, a trade-mark is an instrumentality."

Sup. Ct. R. page 360.

Hanover Star Milling Co. v. Metcalf, 240 U. S. 423.

36 Sup. Ct. R. 357.

It stands for the genuine article, and serves to protect honest dealer and to prevent, and not promote confusion in trade.

National Cigars Stands Co. v. Frishmuth Bros. & Co. Inc., 297 Federal 348, 54.

A trade-mark confers a benefit on the ultimate consumer and the owner alike.

Wallace v. Repetti, 266 Fed. 307;

Certiorari denied Repetti v. Wallace & Co., 254 U. S. 639, 65 L. Ed. 451.

The intentional use of another's trade-mark is a fraud.

Menendez v. Holt, 128 U. S. 514, 32 L. Ed. 526.

The purpose of the "trade-mark" act was to keep the channels of commerce free from the abuses condemned by the act. This is bound to fail of accomplishment if the dealer in intrastate commerce can appropriate the registered mark. Such conduct would burden interstate commerce as effectively as if the user was actually carrying on his business in such commerce.

IV.

The Analysis of Petitioner's Authorities.

We shall proceed to a consideration of the cases relied upon by petitioner in support of the assignments of error.

Under Subdivision A of petitioner's brief, page 4, the Trade-Mark Cases, 100 U. S. 82, is quoted from at length. This case will be considered hereafter in connection with our discussion of the constitutional questions involved.

Under Subdivision B of petitioner's brief, page 5, quotation is made from the language used by Mr. Justice Holmes in Han-

over Star Milling Company v. Metcalf, 240 U. S. 402, 60 L. Ed. 713; 36 Sup. Ct. R. page 357. There is no controversy over the language quoted, but we do call attention to a further statement by Mr. Justice Pitney:

> "It should be added that, so far as appears, none of the parties here concerned has registered the trade-mark under any act of Congress or under the law of any state. Nor does it appear that in any of the states in question there exists any peculiar local rule, arising from statute or decision. Hence, the cases must be decided according to common-law principles of general application" (page 359 Sup. Ct. R.).

The case dealt entirely with a common law trade-mark and the questions of abandonment, non user in a particular market and the subject of estoppel were the only questions considered.

At this point we call attention to the fact that none of the users of the petitioner's labels in the present case had ever registered their labels or trade-marks under any State of Federal law. E. Remy Company of Ohio registered a mark in 1893, but this mark was never renewed under the trade-mark act of 1905 and therefore the owner thereof lost all rights acquired under the early registration (Record page 55).

The Respondent is doing an interstate business and by virtue of the registrations of "Home Brand," the Respondent has a monopoly in all channels of trade throughout the United States; that no one has a right to infringe the trade-mark of the respondent in violation of Chapter 16.

Under Subdivision B of its brief, page 5, petitioner quoted a sentence of Mr. Justice Pitney from the case of

> United Drug Co. v. Rectanus, 248 U. S. 90, 63 L. Ed. 141, 39 Sup. Ct. R. 48.

This was a case where a Mrs. Regis in 1877 adopted a common law trade-mark "REX". In 1898 she registered the trade-mark under the Massachusetts law, and in 1900 she registered the trade-mark under the Act of 1881 and sold her business to United Drug Co., a Massachusetts corporation. Rectanus Company was doing business in Louisville, Kentucky, and spent money in building up a trade. The case in this court turned on the question of prior use. It appears that Mrs. Rex stood by and allowed Rectanus Co., in good faith, to build up a business in Kentucky. The Rectanus Co. had only common law rights. These facts account for the remarks of Mr. Justice Pitney, quoted by the appellant.

This Court pointed out (page 51 of Supreme Court Reporter) that Mrs. Regis had no other than common law rights under the Act of 1881. This court held that a trade-mark conferred no monopoly whatever in a proper sense, but was merely a distinguishing mark, and then said:

> "It results that the adoption of a trade-mark does not, at least in the absence of some valid registration enacted for the purpose, project the right of protection in advance of the extension of trade, or operate as a claim of territorial rights over areas into which it thereafter may be deemed desirable to extend the trade."

Under Subdivision C of its brief, page 7, petitioner refers to the case of

> General Baking Co. v. Gorman, 3 Fed. R. 2nd Ed. 893.

This was clearly a case involving intrastate business. In fact, the complainant, because of his misrepresentations, acquired no good will or other rights which would entitle it to protection by a Court of equity, and if there was any infringement, the complainant was the infringer. The remarks of

counsel are merely repetitions of the remarks in the Trade-Mark Cases (supra) and the Hanover Milling Company case (supra). The question now before this court was not considered.

The case of

Waldes v. International Mfg. Agency (District Court, S. D. New York), 237 Fed. 502 and 506,

referred to on page 8 of petitioner's brief, was a suit for an accounting and injunction and for cancellation of the defendant's trade-mark insofar as it conflicted with plaintiff's own. The case was one of use and the Court held that there was sufficient evidence to establish the plaintiff's use of the trade-mark prior to the defendant's use. That registration conferred no rights and limited none, and was a mere procedural advantage depending on common law ownership and gives scarcely any advantage of any sort, except under Section 16.

The Court does not go into the advantage acquired by this section.

Petitioner refers to the case of

Robertson, Commissioner of Patents v. United States ex rel Baldwin Co., 287 Fed. 943 (page 8 of brief).

In this case the Court drew a distinction between trade-mark cases and patent cases in that it held Section 9 did not entitle a trade-mark owner to bring a suit in equity after an adverse decision on such appeal as is permitted in patent cases; and held the right to a trade-mark existed independently of statute and came into existence by reason of its use and adoption. This decision was reversed

United States ex rel. Baldwin Co. v. Thomas E. Robertson, Commissioner of Patents, 265 U. S. 168, 44 Sup. Ct. R. 498, 68 L. Ed. 962.

This court holding Section 9 was applicable to trade-marks and that Congress intended to give every remedy in respect to trade-marks that is afforded in proceedings as to patents. The effect of registration was not referred to.

V.

THE TRADE-MARK ACT IS CONSTITUTIONAL.

The petitioner cites no authority and advances no argument against the constitutionality of the Trade-Mark law, but in the petition for a writ of certiorari and in the Supreme Court of Ohio the constitutionality of this legislation was questioned and we, therefore, deem it important that the matter be given consideration here.

In the case of

Rossman v. Garnier, 211 Fed. 401,

the Circuit Court of Appeals for the Eighth Circuit had before it for consideration the constitutionality of the Trade-Mark law. During the course of the opinion Judge Smith, speaking for the Court said:

> "The defendant claims the entire trade-mark law of 1905, 33 Stats. 724, is unconstitutional, and inferentially the same contention is made as to the act of 1881, 21 Stats. 502, and of 1882, 22 Stats. 298.
>
> "The first trade-mark legislation passed by Congress, was in 1870, chapter 230 of the Laws of the Forty-first Congress, and is found in 16 Stats. 198. That was entitled 'An act to revise, consolidate, and amend the statutes relating to patents and copyrights.'
>
> "Sections 77 to 84 of this act referred exclusively to trade-marks. There was nothing in the act to refute the presumption quite apparent from its title that it was enacted by Congress in the supposed exercise of its powers

under the eighth clause of the eighth section of the first article of the Constitution.

> 'Sec. 8. The Congress shall have power: • • • To promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.'

"In 1876, 19 Stats. 141, Congress passed an act to punish the counterfeiting of trade-mark goods and the selling or dealing in such goods. This act was for the further security or protection of trade-mark holders under the act of 1870.

"In the Trade-Mark Cases, 100 U. S. 82, 25 L. Ed. 550, the Supreme Court held that no power to pass trade-mark legislation was conferred by the provision of the Constitution quoted and that, as the laws of 1870 and 1876 made no distinction between trade-marks used in intrastate commerce and those used in foreign commerce, interstate commerce, and commerce with the Indian tribes, both of said acts were necessarily void. This decision was rendered in October, 1879, and it was in conformity with what was supposed to have been laid down by the Supreme Court in those cases that all the subsequent legislation upon the subject has been enacted. It is probably true that the constitutionality of the more recent legislation has never been expressly passed upon by the Supreme Court of the United States, but that legislation has now stood for more than 30 years. It has been enforced by the United States Supreme Court and all the other courts of the United States and we see no reason to suppose the law is not sustainable under clause 3 of section 8 of article 1 of the Constitution:

> 'The Congress shall have power: • • • To regulate commerce with foriegn nations, and among the several states, and with the Indian tribes.'

"In Elgin National Watch Co. v. Illinois Watch Case Co., 179 U. S. 665, 675, 21 Sup. Ct. 270, 273 (45 L. Ed. 365), this Court said:

> 'The term (trade-mark) has been in use from a very early date, and, generally speaking, means a distinctive mark of authenticity, through which the products of particular manufacturers or the vendible commodities of particular merchants may be distinguished from those of others.'
>
> "Surely if this be a correct definition of a trade-mark regulations for the registering and protection of them in connection with commerce, interstate or foreign, or with the Indian tribes, is legitimate legislation in connection with the regulation of such commerce. Surely if such marks are distinctive badges of authenticity it is as much a part of the regulation of interstate commerce to regulate them as are the branding features under the pure food law.
>
> "This court cannot therefore hold that such legislation is unconstitutional en bloc."

The Supreme Court of Ohio in the present case considered and passed upon the constitutionality of the trade-mark law. After careful consideration the constitutionality of the Act was sustained (Record pages 16-17).

Congress has under the commerce clause enacted a number of comprehensive statutes for the protection of interstate commerce. For instance, the Federal Trade Commission Act, 38 Stats. 717, was designed to prevent unfair competition in commerce. This law was aimed at abuses in trade and was designed to give protection to those lawfully engaged in interstate commerce against unfair competition. Injunctive relief to prevent unfair competition may be granted under that Act.

> Juvenile Shoe Co. v. Federal Trade Commission, 289 Fed. 57.

The use of false and misleading labels and advertisements may be stopped as unfair methods of competition.

Royal Baking Powder Co. v. Federal Trade Commission, 281 Fed. 744;

Proctor Gamble Co. v. Federal Trade Commission, 11 Fed. (2nd Series) 47.

It is apparent that there is an analogy between the Federal Trade Commission Act and the Trade-Mark law, as both were designed to protect the honest dealer and condemn and punish unfair competition. The constitutionality of the Federal Trade Commission Act has been sustained.

National Harness Mfg. Ass'n. v. Federal Trade Comm., 268 Fed. 705;

United States v. Basic Products Co., 260 Fed. 472;

Federal Trade Commission v. P. Lanllord Co., 283 Fed. 999;

Affirmed in 264 U. S. 298, 68 L. Ed. 696;

Sears-Roebuck & Co. v. Federal Trade Commission, 258 Fed. 307;

Chamber of Commerce of Minneapolis v. Federal Trade Commission, 280 Fed. 45.

As illustrative of the authority of Congress over interstate commerce attention is called to

United States v. Ferger, 250 U. S. 199, 63 L. Ed. 937,

the Court said:

> "Nor is the situation helped by saying that as the manufacture and use of the spurious interstate commerce bills of lading were local, therefore the power to deal with them was exclusively local, since the proposition disregards the fact that the spurious bills were in the form of interstate commerce bills, which, in and of themselves, involved the potentiality of fraud so far-reaching, and all embracing as the flow of the channels of interstate commerce in which it was contemplated the fraudulent bills would circulate."

Congress under the commerce clause enacted the Pure Food and Drug Act, 34 Stats. 768. This law has been sustained as a legitimate exercise of the power to regulate interstate commerce.

Weeks v. United States, 245 U. S. 620, 62 L. Ed. 513;
McDermott v. Wisconsin, 228 U. S. 115, 57 L. Ed. 754.

The purpose of the Act is to advise purchasers of what they are buying and that the article purchased is what it purports to be.

U. S. v. Antikamnia Chemical Co., 234 U. S. 654, 58 L. Ed. 419.

Misbranding of merchandise in Commerce is condemned by the Act.

Savage v. Jones, 225 U. S. 501, 56 L. Ed. 1182.

It would seem on principle that, if Congress has authority to legislate under the commerce clause on the misbranding of food and drugs, that it would have like authority to prevent by legislation the use of a registered trade-mark by any one than the owner thereof in Interstate Commerce. A fraud and deception results in the latter case as much as in the former.

The powers conferred upon Congress to regulate commerce, means not only to regulate but prohibit. An embargo may be placed upon commerce prohibited by law.

Champion v. Ames, 188 U. S. 321, 47 L. Ed. 492 (The lottery case).

In the above case the Supreme Court sustained an Act of Congress preventing the transportation of lottery tickets in Interstate Commerce.

The power of Congress to regulate commerce is not to be tested by the intrinsic interest of commerce in the particular subject dealt with instead of by the relation of that subject to commerce and its effect upon it. The power to regulate commerce includes the power to deal with obstructions to that commerce.

Re Debs, 158 U. S. 564, 39 L. Ed. 1092;

First National Bank v. Fellows, 244 U. S. 416, 61 L. Ed. 1233;

United States v. Ferger, 250 U. S. 199; 63 L. Ed. 936.

The only decision of this Court passing upon the constitutionality of trade-mark legislation which has come to our attention is the Trade-Mark Cases, 100 U. S. 82, 25 L. Ed. 550. That case involved the Trade-Mark Act of 1870 and a penal statute enacted in 1876.

With reference to the authority of Congress over the subject of Trade-Marks the Court, speaking through Mr. Justice Miller, said:

> "The question, therefore, whether the trade-mark bears such a relation to Commerce in general terms as to bring it within Congressional control, when used or applied to the classes of Commerce which fall within that control, is one which, in the present case, we propose to leave undecided. We adopt this course because when this court is called on in the course of the administration of the law to consider whether an act of Congress, or any other department of the Government is within the constitutional authority of that department, a due respect for a co-ordinate branch of the Government, requires that we shall decide that it has transcended its powers only when that is so plain that we cannot avoid the duty."

And further,

> "In what we have here said we wish to be understood as leaving the whole question of the treaty making power of the general government over trade-marks, and of the duty of Congress to pass any laws necessary to carry such treaties into effect, wholly untouched."

It is apparent from the language used that this Court did not pass upon the power of Congress to legislate on the subject of trade-marks under the commerce clause of the constitution.

The authority of Congress over interstate commerce was commended upon by Mr. Justice Hughes in the case of

> Houston East & West Texas Ry. Co., et al. v. United States, et al, 234 U. S. 342, 58 L. Ed. 1341,

as follows:

> "It is unnecessary to repeat what has frequently been said by this court with respect to the complete and paramount character of the power confided to Congress to regulate commerce among the several states. It is of the essence of this power that, where it exists, it dominates. Interstate trade was not left to be destroyed or impeded by the rivalries of local government. The purpose was to make impossible the recurrence of the evils which had overwhelmed the Confederation, and to provide the necessary basis of national unity by insuring 'uniformity of regulation against conflicting and discriminating state legislation.' By virtue of the comprehensive terms of the grant, the authority of Congress is at all times adequate to meet the varying exigencies that arise, and to protect the national interest by securing the freedom of interstate commercial intercourse from local control * * *.
>
> "Congress is empowered to regulate,—that is, to provide the law for the government of interstate commerce; to enact 'all appropriate legislation' for its 'protection and advancement' * * *; to adopt measures 'to promote its

growth and insure its safety' * * *; 'to foster, protect, control, and restrain'."

CONCLUSION.

It is respectfully submitted that the rights of the respondent in the Trade-Mark "Home Brand" were projected by the Act of 1905 into the channels of Interstate Commerce and that the petitioner by printing and publishing infringing labels, which were attached by its customers to their products and sold by such customers in the territory in which respondent was engaged in business, violated the registered trade-mark rights of respondent, and that the decision of the Supreme Court of Ohio in this case should be affirmed.

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APPENDIX.

The Trade Mark Act of 1905.

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APPENDIX.

THE TRADE MARK ACT OF 1905.

SECTION 5. Trade-marks which may be registered. That no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark unless such mark—

"(a) Consists of or comprises immoral scandalous matter.

"(b) Consists of or comprises the flag or coat of arms or other insignia of the United States or any simulation thereof, or of any State or municipality or of any foreign nation, or of any design or picture that has been or may hereafter be adopted by any fraternal society as its emblem, or of any name, distinguishing mark, character, emblem, colors, flags, or banner adopted by any institution, organization, club, or society which was incorporated in any State in the United States prior to the date of the adoption and use by the applicant: Provided, That said name, distinguishing mark, character, emblem, colors, flag, or banner was adopted and publicly used by said institution, organization, club, or society prior to the date of adoption and use by the applicant: Provided, That trade-marks which are identical with a registered or known trade-mark owned and in use by another and appropriated to merchandise of the same descriptive properties, or which so nearly resemble a registered or known trade-mark owned and in use by another and appropriated to merchandise of the same descriptive properties as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers shall not be registered: Provided, That no mark which consists merely in the name of an individual, firm, corporation, or association not written, print-

ed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual, or merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term, shall be registered under the terms of this Act: Provided further, That no portrait of a living individual may be registered as a trade-mark except by the consent of such individual, evidenced by an instrument in writing: And provided further, That nothing herein shall prevent the registration of any mark used by the applicant or his predecessors, or by those from whom title to the mark is derived, in commerce with foreign nations or among the several States or with Indian tribes which was in actual and exclusive use as a trade-mark of the applicant, or his predecessors from whom he derived title, for ten years next preceding February twentieth, nineteen hundred and five: Provided further, That nothing herein shall prevent the registration of a trade-mark otherwise registrable because of its being the name of the applicant or a portion thereof.

SECTION 8. Appeal from Decision of examiner. That every applicant for the registration of a trade-mark, or for the renewal of the registration of a trade-mark, which application is refused, or a party to an interference, against whom a decision has been rendered, or a party who has filed a notice of opposition as to a trade-mark, may appeal from the decision of the examiner in charge of trade-marks, or the examiner in charge of interferences, as the case may be, to the Commissioner in person, having once paid the fee for such appeal.

SECTION 9. Appeal to Court of Appeals, D. C. That if an applicant for registration of a trade-mark, or a party to an interference as to a trade-mark, or a party who has filed opposi-

tion to the registration of a trade-mark, or party to an application for the cancellation of the registration of a trade-mark, is dissatisfied with the decision of the Commissioner of Patents, he may appeal to the court of appeals of the District of Columbia, on complying with the conditions required in case of an appeal from the decision of the Commissioner by an applicant for patent, or a party to an interference as to an invention, and the same rules of practice and procedure shall govern in every stage of such proceedings, as far as the same may be applicable.

SECTION 16. That the registration of a trade-mark under the provisions of this act shall be prima facie evidence of ownership. Any person who shall, without the consent of the owner thereof, reproduce, counterfeit, copy, or colorably imitate any such trade mark and affix the same to merchandise of substantially the same descriptive properties as those set forth in the registration, or to labels, signs, prints, packages, wrappers, or receptacles intended to be used upon or in connection with the sale of merchandise of substantially the same descriptive properties as those set forth in such registration, and shall use, or shall have used, such reproduction, counterfeit, copy, or colorable imitation in commerce among the several States, or with a foreign nation, or with the Indian tribes, shall be liable to an action for damages therefor at the suit of the owner thereof; and whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment therein for any sum above the amount found by the verdict as the actual damages, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs.

SECTION 17. Jurisdiction of courts. That the circuit and territorial courts of the United States and the supreme court of the District of Columbia shall have original jurisdiction, and the circuit courts of appeal of the United States and the

court of appeals of the District of Columbia shall have appellate jurisdiction of all suits at law or in equity respecting trade-marks registered in accordance with the provisions of this Act, arising under the present Act, without regard to the amount in controversy.

SECTION 19. Injunctions, assessment of damages. That the several courts vested with jurisdiction of cases arising under the present Act shall have power to grant injunctions, according to the course and principles of equity, to prevent the violation of any right of the owner of a trade-mark registered under this Act, on such terms as the court may deem reasonable; and upon a decree being rendered in any such case for wrongful use of a trade-mark the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby, and the court shall assess the same or cause the same to be assessed under its direction. The court shall have the same power to increase such damages, in its discretion, as is given by section sixteen of this Act for increasing damages found by verdict in actions of law; and in assessing profits the plaintiff shall be required to prove defendant's sales only; defendant must prove all elements of costs which are claimed.

SECTION 22. Interference cases may be brought in equity courts. That whenever there are interfering registered trade-marks, any person interested in any one of them may have relief against the interfering registrant, and all persons interested under him, by suit in equity against the said registrant; and the court, on notice to adverse parties and other due proceedings had according to the course of equity, may adjudge and declare either of the registrations void in whole or in part according to the interest of the parties in the trade-mark, and may order the certificate of registration to be delivered up to the Commissioner of Patents for cancellation.

(2)

SUPREME COURT OF THE UNITED STATES.

No. 372.—October Term, 1928.

The United States Printing and Lithograph Company, Petitioner, *vs.* Griggs, Cooper and Company. } On Writ of Certiorari to the Supreme Court of the State of Ohio.

[April 8, 1929.]

Mr. Justice Holmes delivered the opinion of the Court.

This is a suit brought by the respondent, a corporation of Minnesota, against the petitioner, a corporation of Ohio, alleging that the plaintiff has a trade mark 'Home Brand', registered in the Patent Office for various grocers' goods which it sells at wholesale in certain named States of the northwest; and that the defendant is printing and selling labels for similar grocers' goods, containing the word 'Home', which labels are used by the purchasers in States other than those in which the plaintiff has established a market. No interference with interstate or foreign commerce is alleged. The bill seeks an injunction against printing and selling such labels for any groceries that the plaintiff sells. The trial court found the facts to be as above stated and the Supreme Court held that the "purpose and effect of the [Trade Mark Act of February 20, 1905, c. 592, § 16; 33 Stat. 728, (C., Tit. 15, § 96)] was to project the trade mark rights of the registrant and owner thereof into all the states even in advance of the establishment of trade therein, and to afford full protection to such registrant and owner." It affirmed a judgment for the plaintiff giving the relief prayed and a writ of certiorari was granted by this Court.

In the *Trade Mark Cases*, 100 U. S. 82, it was held that the earlier acts attempting to give these unlimited rights were beyond the power of Congress. Soon after that decision an Act of March 3, 1881, gave remedies for the wrongful use of a registered trade mark in foreign commerce or commerce with Indian Tribes. It was said that obviously the Act was passed in view of the above

mentioned case, that only the trade mark used in such commerce was admitted to registry and that the registered mark could only be infringed when used in that commerce. *Warren* v. *Searle & Hereth Co.*, 191 U. S. 195, 204, (see *United Drug Co.* v. *Theodore Rectanus Co.*, 248 U. S. 90, 99,) and the constitutionality of the Act even when so limited was left open. 191 U. S. 206. The Act of 1905 goes a little farther and gives remedies against reproduction, &c., of the registered trade mark 'in commerce among the several States' as well as in commerce with foreign nations, &c., § 16, *supra*. A remedy for such infringement was given in *Thaddeus Davids Co.* v. *Davids Manufacturing Co.*, 233 U. S. 461, see also *American Steel Foundries* v. *Robertson*, 262 U. S. 209. *Baldwin Co.* v. *Robertson*, 265 U. S. 168. But neither authority nor the plain words of the Act allow a remedy upon it for infringing a trade mark registered under it, within the limits of a State and not affecting the commerce named. More obviously still it does not enlarge common law rights within a State where the mark has not been used. *General Baking Co.* v. *Gorman*, 3 F. (2d) 891, 894. Some attempt was made to support the decision upon other grounds, but we do not think them presented by the record, and they are not mentioned by the Ohio Court.

Judgment reversed.

A true copy.

Test:

Clerk, Supreme Court, U. S.